

***United States Court of Appeals
for the
District of Columbia Circuit***



**TRANSCRIPT OF
RECORD**

JOINT APPENDIX

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT *United States Court of Appeals
For the
District of Columbia*

11,454

FILED SEP 5 1952

SEARS, ROEBUCK AND CO., *Appellant,*

v.

~~JOHN A. MARZALL~~, Commissioner of Patents, *Appellee.*

R. C. Watson

Appeal from the United States District Court for the
District of Columbia

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JOINT APPENDIX

I.

**PLEADINGS, DOCKET ENTRIES AND OTHER
PAPERS**

62

Filed Apr 3 1951

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

No. 1374-51

Suit in Equity Under Sec. 4915 R. S. to Enforce
Registration of a Trade MarkSEARS, ROEBUCK AND Co., 925 South Homan Avenue,
Chicago, Ill., *Plaintiff*,

v.

JOHN A. MARZALL, Commissioner of Patents, *Defendant*.**Complaint**To the Honorable Judges of the U. S. District Court for the
District of Columbia:

SEARS, ROEBUCK AND Co., Plaintiff, a corporation of the State of New York, having its principal place of business at 925 South Homan Avenue, City of Chicago, County of Cook and State of Illinois, brings this suit in equity against JOHN A. MARZALL, a resident of the District of Columbia, in his official capacity as Commissioner of Patents of the United States, under the provisions of United States Code, Title 35, Section 63 (R. S. 4915), to require the Commissioner to grant the registration of plaintiff's trade mark.

1. Plaintiff and its predecessors in business have been engaged in the retailing of consumer merchandise of various types and descriptions since the year 1886. Plaintiff has conducted its business over this entire period by mail order, periodically issuing catalogs describing the merchandise offered for sale and shipping goods out to customers throughout the United States in interstate and intrastate

commerce pursuant to orders received by Plaintiff through the mail.

(a) Plaintiff has also for many years sold consumer merchandise through a large number of retail stores scattered throughout the United States, and in connection with Plaintiff's business in the aforesaid stores, Plaintiff has advertised its merchandise in daily newspapers throughout the United States.

2. In the year 1908 a person was employed by
63 Plaintiff by the name of "John Higgins" (hereinafter referred to as "Higgins"). Desiring a trade mark for its sporting goods, Plaintiff requested of said Higgins, and Higgins granted to Plaintiff, the right to use the personal name of said Higgins as a trade mark for said goods. Pursuant to the right and privilege granted by said Higgins to Plaintiff, as aforesaid, Plaintiff adopted the name of said Higgins as a trade mark for sporting goods in the form "J. C. Higgins", which was approved by said Higgins. Plaintiff, thereupon, began in 1908 to apply the trade mark "J. C. Higgins" to sporting goods sold by Plaintiff and said practice has continued thereafter and continuously up to the present time. Plaintiff has extended its use of the trade mark "J. C. Higgins" to a large line of merchandise since Plaintiff's first adoption of the trade mark, as aforesaid, and merchandise marked with the trade mark "J. C. Higgins" has been sold by Plaintiff in extremely large quantities in interstate and intrastate commerce throughout the United States continuously since said date, as aforesaid.

(a) Since Plaintiff's first adoption of said trade mark, as aforesaid, Plaintiff has widely advertised its merchandise under the trade mark "J. C. Higgins", both in its mail order catalogs and in the daily newspapers throughout the United States, continuously since the adoption of said trade mark, and said advertising has covered substantially all of the items of merchandise to which Plaintiff has applied said mark, and Plaintiff has spent large sums of money in said advertising.

3. During the lifetime of said Higgins Plaintiff filed in the United States Patent Office 17 applications for the registration of Plaintiff's trade mark "J. C. Higgins" under the Trade Mark Act of 1946 for a large group of merchandise classified by the Trade Mark Division of the Patent Office in 17 different classes, one of said applications being identified in the Patent Office as Ser. No. 548,852 filed February 5, 1948. Said application covers "Shotguns, Rifles, Gun Sights, Gun Cases and Ammunition Belts" and is classified in Patent Office Class 9, Explosives, firearms, equipments, and projectiles.

64 4. In all of said 17 applications filed by Plaintiff for the registration of its trade mark "J. C. Higgins", as aforesaid, Plaintiff filed a verified statement (or photostatic copy thereof) addressed to Plaintiff by said Higgins, a true photostatic copy of which is attached hereto, marked Plaintiff's Exhibit A, said statement reading as follows:

"This will confirm that, while employed as an executive of your Company in 1908, my name was adopted, with my permission, by the sporting goods department as a trade mark for baseball supplies. The name applied to the merchandise is 'J. C. Higgins.'

"This name has been used continuously by your firm since that time, having been extended to other items with my approval.

"This letter is your authority to continue the use of 'J. C. Higgins' and secure registration thereof, as a trade mark for sporting goods and any other items of merchandise to which you may wish to extend said trade mark."

5. The Commissioner of Patents was requested in all of said 17 applications, including Ser. No. 548,852, that Plaintiff's trade mark "J. C. Higgins" be registered to Plaintiff as the name of a living individual whose consent was given, or as a *bona fide* trade mark which had long been used by Plaintiff in interstate and intrastate commerce and

subject to no provision of the Trade Mark Act of 1946 which would prohibit the registration of said trade mark.

6. All of the requirements of the statutes of the United States and all lawful rules of the United States Patent Office now in force relating to the filing, prosecution and granting of registrations of trade marks under the Trade Mark Law of 1946 have been duly complied with and Plaintiff has exercised due diligence and has complied with all lawful requirements of the Patent Office in Plaintiff's effort to obtain registration of its trade mark "J. C. Higgins" in said application Ser. No. 548,852.

7. On or about November 3, 1949, the Assistant Commissioner of Patents of the United States Patent Office considered on appeal from the Examiner of Trade
65 Marks an application for registration of the trade mark "Andre Dallieux" (*Ex parte Dallieux*, 83 P. Q. 262), which had been refused registration by the Examiner on the ground that said trade mark was "merely a surname" and, therefore, not registrable in view of Section 2 (e) of the Trade Mark Act of 1946, unless shown to have acquired distinctiveness in accordance with Section 2 (f) of said Act. The Assistant Commissioner of Patents, in reversing the Examiner of Trade Marks, held that the Examiner was construing Section 2 (e) of the Trade Mark Act of 1946 as identical in meaning with the Trade Mark Act of 1905, which prohibited registration of a mark which "consists merely in the name of an individual"; and the Commissioner further held that unless a trade mark consisting of the name of an individual were written in such a manner that the surname was unduly emphasized or otherwise constituted the only significant part of the trade mark, such a trade mark should be registered under the Trade Mark Act of 1946.

8. Despite the ruling of the Assistant Commissioner of Patents in *Ex parte Dallieux*, which decision was brought to the attention of the Examiner of Trade Marks in Plaintiff's application Ser. No. 548,852, the Examiner persist-

ently refused to register Plaintiff's trade mark "J. C. Higgins", not only in the aforesaid application Ser. No. 548,852 but in all of the other of Plaintiff's applications covering its trade mark "J. C. Higgins", and on February 1, 1950, finally refused registration in said Ser. No. 548,852, holding the name Higgins to be "the only significant part of the mark", while admitting that a full personal name would properly be registrable.

9. In accordance with the laws and rules of the United States Patent Office, Plaintiff appealed to the Commissioner of Patents to reverse the aforesaid decision of the Examiner of Trade Marks in refusing registration of Plaintiff's trade mark "J. C. Higgins" in said application Ser. No. 548,852, and said appeal was considered by Examiner-in-Chief P. J. Federico. In a decision dated December 12, 1950, said Examiner-in-Chief affirmed the Examiner of Trade Marks in said application Ser. No. 548,852. In his decision the Examiner-in-Chief, while not attempting to overrule the decision of the Assistant Commissioner
66 of Patents in *Ex parte Dallieux*, held that the addition of initials to a surname in the personal name "J. C. Higgins" rendered the mark "primarily merely a surname" and, therefore, unregistrable under the Act of 1946. The Examiner-in-Chief endeavored to support his conclusion by the citation of certain decisions to the effect that a trade mark involving a personal name including initials was not registrable over the same name lacking any initials, although the Examiner-in-Chief admitted that "these cases were not concerned with the same problem involved here." The Examiner-in-Chief further asserted, for the first time in Plaintiff's said application Ser. No. 548,852, that in any event Plaintiff's trade mark "J. C. Higgins" was not properly registrable without a disclaimer of the surname "Higgins", although this point had not been mentioned previously by any official of the Patent Office at any time in the prosecution of the application, and although no disclaimer of the surname had been required in the case of *Ex parte Dallieux*.

10. Plaintiff avers that the Commissioner of Patents and his subordinates have unlawfully refused to register Plaintiff's trade mark "J. C. Higgins" and have persisted in interpreting the Trade Mark Act of 1946 as synonymous with the Act of 1905, despite the ruling of the Commissioner of Patents clearly distinguishing the pertinent provisions of said Acts in *Ex parte Dallieux*, which decision never to Plaintiff's knowledge has been expressly overruled, but, on the contrary, has been reaffirmed in Plaintiff's application Ser. No. 548,852; that the Commissioner and his assistants have unlawfully attempted to dissect Plaintiff's trade mark, arbitrarily assigning to it stress or emphasis in connection with the surname "Higgins" which is not warranted by the manner in which the trade mark is applied to the goods; that, furthermore, in attempting unlawfully to dissect the trade mark, which is applied to the goods as a unitary personal name simulating a signature, the Examiner-in-Chief unlawfully asserted that the surname "Higgins" should be disclaimed, and that the Commissioner has unlawfully refused registration to Plaintiff. A specimen label showing Plaintiff's trade mark as applied to the goods is attached hereto and marked Plaintiff's Exhibit B.

11. No appeal has been taken from said decision of the Commissioner of Patents to the Court of Customs and Patent Appeals, and no such appeal is pending or has been decided.

Plaintiff hereby makes profert of certified copies of Plaintiff's aforesaid trade mark application Ser. No. 548,852, or necessary portions thereof, as this Honorable Court shall direct.

WHEREFORE, Plaintiff prays:

(a) That this Honorable Court declare that Plaintiff is entitled to registration of its trade mark "J. C. Higgins", under the Trade Mark Act of 1946, apart from any requirement of Section 2 (f) of said Act, and to declare further that no disclaimer of the surname "Higgins" should be required.

(b) That the Commissioner of Patents be directed to allow and publish Plaintiff's trade mark in accordance with law.

(c) For such other and further relief as equity may require.

SEARS, ROEBUCK AND CO.

By FRANK H. MARKS

S. J. COLLONS

Attorneys for Plaintiff

120 South La Salle Street

Chicago, Illinois

March 23, 1951.

Of Counsel:

IVAN P. TASHOF

Munsey Building

Washington 4, D. C.

* * * * *

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Filed Apr 3 1951

Plaintiff's Exhibit A

Sears, Roebuck and Co.,

925 S. Homan Ave.,

Chicago 7, Ill.

Gentlemen:

This will confirm that, while employed as an executive of your Company in 1908, my name was adopted, with my permission, by the sporting goods department as a trade mark for baseball supplies. The name applied to the merchandise is "J. C. Higgins."

This name has been used continuously by your firm since that time, having been extended to other items with my approval.

This letter is your authority to continue the use of "J. C. Higgins" and secure registration thereof, as a trade mark

for sporting goods and any other items of merchandise to which you may wish to extend said trade mark.

Very truly yours,

JOHN HIGGINS

October 13, 1948
(Date)

STATE OF ILLINOIS
County of Cook, ss

Before me personally appeared John Higgins to me known to be the person described in the foregoing statement, who signed the foregoing instrument in my presence, and made oath before me to the allegations set forth therein, on the 13th day of October, 1948.

MARGARET WELSH
(Notary Seal) (Notary Public)

* * * * *

FILED
APR 3 1951
HARRY M. BULL, CLERK



NO. 097 REPEATING SHOTGUN 12 GAUGE 28" BARREL FULL CHOKE

J. C. HIGGINS SHOTGUNS ARE SOLD ONLY BY SEARS, ROEBUCK AND CO.

PLAINTIFF'S EXHIBIT B

72

Filed Jun 6 1952

Answer to the Complaint

To the Honorable the Judges of the United States District Court for the District of Columbia.

The defendant admits the allegations of the introductory paragraph of the complaint.

1. He admits the allegations of paragraph 1.
2. He is not informed, except by the complaint itself, as to the allegations of paragraph 2.
3. He admits the allegations of paragraph 3 so far as they relate to application No. 548,852. He is not informed, except by the complaint, as to the other sixteen applications which are referred to but not identified in
73 paragraph 3.
- 4, 5. He admits the allegations of paragraphs 4 and 5 with respect to application No. 548,852. In other respects he is not informed, except by the complaint, as to the allegations of those paragraphs.
6. He admits that all formal requirements have been complied with in respect to application No. 548,852. He denies for the reasons given in the statement of the Examiner in answer to the plaintiff's appeal and in the decision of the Examiner-in-Chief that the plaintiff is entitled to the registration sought. Profer of copies of the said statement and decision is hereby made.
7. He admits the allegations of paragraph 7 except those contained in the last five lines of that paragraph; the latter allegations he denies.
8. He admits the allegations of paragraph 8 so far as they relate to application No. 548,852. He is not informed, except by the complaint, as to the remaining allegations of that paragraph.

9. He admits the allegations of paragraph 9.
10. He denies the allegations of paragraph 10.
11. He admits the allegations of paragraph 11.

Respectfully submitted,

E. L. REYNOLDS
Solicitor, U. S. Patent Office,
Attorney for Defendant.

April 13, 1951

* * * * *

II.

EXCERPTS FROM TESTIMONY AND PROCEEDINGS

- 3 Mr. Marks: May it please Your Honor, this is an
 action under Section 4915, revised statutes, in which
 the plaintiff, Sears Roebuck & Company, is asking
 4 Your Honor to order the Commissioner of Patents
 to grant a trade-mark registration.

The trade-mark involved consists of "J. C. Higgins" which is one of the major Sears Roebuck trade-marks.

I have here the entire certified file history from the Patent Office which I would like to offer in evidence at this time.

The Court: No objection, Mr. Schimmel?

Mr. Schimmel: No objection, Your Honor.

Mr. Marks: It shows the drawing of the trade-mark.

The Court: All right, sir, it will be received, there being no objection.

(Certified copy of the Patent Office file was marked Plaintiff's Exhibit No. 1 and received in evidence.)

* * * * *

- 18 I would also like to hand to Your Honor these
 19 pages from the Washington Telephone Directory,
 cover page and page 293 and I might say I selected
 this page at random from the Washington Telephone
 Directory.

I just happened to open the book at this page 293 of the November, 1951, portion of the D. C. phone book, just to see how people are identified, and, well, let's take the third column, for example. We can look at it anywhere on the page and read down the list of Douglas' who are identified. Now, these people are identified in this way so that these names designate certain particular individuals, and what do we find?

We find the first Douglas is Irvin;
 The next one is Isabella;
 The next one is J. F., Jr.;
 The next one is J. S.;
 J. S., Jr.;
 J. W.;
 Mrs. J. W.

And so on, and so on.
 You can go on throughout the whole page, and you will find that many individuals on that page—and all the way through the phone book, of course, the same thing would apply—are identified merely by initials.

* * * * *

35 The Court: What is going to constitute your case?

Mr. Marks: I have a witness here, Your Honor.

The Court: As to what?

Mr. Marks: He is going to tell Your Honor something about the background of the adoption of this case, and the importance of it, and so forth, to the company.

The Court: I cannot determine it on importance, can I?

Mr. Marks: No, I suppose not. It would simply give Your Honor—

The Court: I could assure you that I will treat your presentation as a serious claim for something which you think is important to your company. If that is what you are going to have him say, you need not do it.

Mr. Marks: I have examples of labels that I would like to put into evidence through this witness showing how the

trade-mark is used and I also have, Your Honor, if you would like an outline of our expected evidence, we also have several bits of evidence to show how the name is regarded by the public; that it is always referred to by the public as "J. C. Higgins."

Indicating, of course, that the name "Higgins" is not dominant as the Patent Office assumes, but that this trade-mark is regarded by the public as a complete name
36 "J. C. Higgins."

I feel that that is important, Your Honor. We have literature from outside the company, in various publications, referring to J. C. Higgins merchandise. Always referring to J. C. Higgins.

I think that is important, in view of the attitude that the Patent Office has taken that the initials may be just disregarded. They are not disregarded by the public.

Mr. Schimmel: In this connection I would like to call Your Honor's attention to the fact that in the decision, on page 4—

The Court: Which one, sir?

Mr. Schimmel: The appeal decision—the statement is made:

"There is no question as to the capability of the mark in this case to function and distinguish applicant's goods, and the specimens accompanying the application in the manner in which the mark is used unquestionably shows trade-mark use."

It is not in issue here.

Mr. Marks: That is all very well. Of course, there is no question as to trade-mark use, but you continually maintain, and you have in the Patent Office, all the way from the Examiner on up, that the name is a family name; the surname is the dominant feature of the mark; the
37 initials may be disregarded; they are meaningless in effect.

Well, now, I am prepared to show Your Honor that the public in general considers these initials important.

The Court: How are you going to show the public in general, sir?

Mr. Marks: Beg pardon?

The Court: How will you show the public in general?

Mr. Marks: Well, we have a representative sampling of inquiries that have come in to the company; they have just been taken at random; letters that come in from purchasers or would-be purchasers and prospective purchasers.

The Court: Suppose you make a proffer of what you would expect to show if you did in fact call the witnesses.

Mr. Marks: Well, perhaps we can stipulate.

Mr. Schimmel: I don't think there is any room here for any evidence to show that this mark is distinctive with applicant. There isn't any issue in this case on that.

The Court: If there is no issue, I don't see where it makes much difference.

Mr. Marks: It goes right down to this issue, that the Patent Office has raised, that the surname is the dominant feature. I say that it is not the dominant feature.

We have letters here, and orders, from people writing in to Sears Roebuck inquiring into and ordering J. C. Higgins merchandise, and invariably they refer to it as J. C. Higgins.

38 We find in practically no instance do they ever say "Higgins."

Mr. Schimmel: May I point out that plaintiff in his opening statement said this was a question of law involved.

The Court: I understood that, too.

Mr. Marks: Well, that is true, but I am here for trial, Your Honor. I think that that is a part of my case.

The Court: Well, you make a proffer of what you would expect to show and we will see where we go from there.

Mr. Marks: I have here 14 orders from customers on Sears, Roebuck & Company, including—

The Court: Fourteen orders from whom?

Mr. Marks: These are orders from customers.

The Court: All right, sir.

Mr. Marks: These orders were selected—I should not say “selected”—they were taken pursuant to a request to collect any orders over a given period calling for J. C. Higgins merchandise.

And in each of these orders there is at least one item ordered under the trade-mark J. C. Higgins.

The Court: And that covers what period of time, sir?

Mr. Marks: These were taken the early part of this year. No, I beg your pardon—

Some of these were collected in 1946 in accordance with the company routine of, when a trade-mark is extended to any new lines, to establish the date. It was taken in 1946 and some of them as late as 1952.

There are some here for January, 1952.

The Court: And these are 14 in number?

Mr. Marks: They are 14 orders.

The Court: And in those you say that they are from customers and they refer to J. C. Higgins?

Mr. Marks: Various J. C. Higgins goods; shotguns, for example.

The Court: Are you in a position to show over that period of time how many orders have come in by your company which would deal with goods of Higgins?

Mr. Marks: I would like to put the witness on the stand to give that information, Your Honor.

The Court: The witness is there.

Can you answer that, sir?

Mr. Downey: No, I cannot answer it.

The Court: Suppose you get 14 out of a million. That does not mean much, does it?

Mr. Marks: He knows what he requested, Your Honor. He did not pull these. This man merely requested the collection of the orders by the department which had the facilities to do that, and he can tell Your Honor what he requested.

The Court: All right. What else would you like to offer?

40 Mr. Downey: Most of our orders come in with just a catalogue number but, where they do, then as a result we don't find the use of J. C. Higgins so often, but where they do, it is invariably this J. C. Higgins.

Now, our sales for J. C. Higgins merchandise in 1951 were more than fifty-six and one-half million dollars.

The total sales since we have used that name—

The Court: I want to find out what else is being proffered, to see where we go.

Mr. Marks: Now, I also have, Your Honor, a collection of original letters, 14 original letters from prospective customers, addressed to Sears and inquiring with regard to J. C. Higgins merchandise, and out of those 14 I think there is one postcard—no, the postcard is missing, but my witness tells me there was one postcard which refers to the goods as Higgins, and he has requested that to be sent along. I told him we wanted all of them whether they referred to it as Higgins or J. C. Higgins.

The Court: And what period do they cover?

Mr. Downey: January and February a check was made, 1952.

Mr. Marks: Here is one that is dated December 30, 1951.

The Court: I assume that your statement with reference to these letters would be quite similar to your treatment of the 14 orders; most of them coming in do not refer
41 to J. C. or to Higgins, but by catalogue number, sir?

Mr. Downey: I would say there are not too many letters of this type with regard to the merchandise unless they sometimes use the number only, but these particular letters show they requested mostly shotguns, and that resulted from a national magazine advertisement.

The Court: Well, you are not answering my question. I don't know if you can or not.

I am asking you if your comment as to the 14 orders to which counsel has referred is equally applicable to the 14 letters. In other words—

Mr. Downey: Yes.

The Court: In other words, there are a few letters which come in which refer to either Higgins or to J. C. Higgins. They utilize the number of the catalogue or something of that sort.

Mr. Downey: The letters either refer to J. C. Higgins or they don't mention the trade-mark at all.

Only one case in the time we have made a check did we find any correspondence where they just used the word Higgins.

The Court: You are still not answering my question.

Mr. Downey: I am sorry. I did not understand.

The Court: I understood you to say to counsel that the 14 orders to which he referred, which referred to 42 J. C. Higgins, and covering the period from 1946 to January, 1952, constitutes a small part of any business which you have with reference to your goods.

Mr. Downey: Very well.

The Court: Because, most of your orders come in by virtue of a catalogue number.

Mr. Downey: That is correct.

The Court: Now, query: Is that comment equally applicable to the 14 original letters which counsel has?

Mr. Downey: Yes.

The Court: All right.

Mr. Marks: I think we might add here also, Your Honor, that I requested these letters, requested Mr. Downey to collect the letters only about the beginning of this year. Isn't that correct, Mr. Downey?

Mr. Downey: That is true.

Mr. Marks: So, there was no attempt made to collect letters before 1952.

The Court: All right, sir.

Mr. Marks: It was only in preparation for this trial.

I wanted to see how the customers, in writing in, would refer to this merchandise, and asked him to collect the correspondence for that purpose.

The Court: All right, sir.

Now, what else would you like to proffer?

43 Mr. Marks: I also have here, Your Honor, three articles, or photostats of those articles—I think I may have one of the original publications. These are nationally distributed periodicals pertaining to sporting goods which mention J. C. Higgins goods. I think it is all guns.

Isn't that correct, Mr. Downey?

Mr. Downey That is right.

Mr. Marks: There is one here, for example, "Gun Guide," which mentions the J. C. Higgins gun along with the Stevens pump gun, and something else.

Then the next one is "Sports Afield," which refers to a J. C. Higgins (Sears) Model 20.

And here is a third, "Sports Afield," publication, which includes among others such as a Winchester, Mossberg, and certain other guns, and Stevens, and it mentions the J. C. Higgins Model 30.

Now, these are publications over which the plaintiff has no control whatever, and my purpose is to show recognition in the industry of the trade-mark J. C. Higgins as a complete entity.

Here is another one, Your Honor.

The Court: That is in addition to the three?

Mr. Marks: In addition, Your Honor. It shows an advertisement sponsored by Sears in "Field and Stream" of November, 1951, and another one for September, 1951; both of
44 them advertising a J. C. Higgins gun, showing its use in national advertising, apart from its own catalogue medium.

I have a mass of their own advertising here, Your Honor, and I think to make this record complete, we would like to show how the company has always referred to it in their own advertising.

I have a representative sampling of Sears catalogues over a period of—well, since 1935, and that would be about 17 years—showing it always referred to J. C. Higgins, and in no case is the surname given any particular emphasis.

I feel, Your Honor, that that is important.

The Court: Well, you are protected if you make the proffer, sir. I mean, if it is important.

Are those the things which you would like to show, sir?

Mr. Marks: No, in addition I think the only thing aside from that, Your Honor, aside from this advertising material, is a collection—I might add, we also have retail advertising by Sears in the various newspapers which show about the same thing.

The Court: In the daily press?

Mr. Marks: In the daily press, which is put out by the various Sears stores throughout the country, and which shows about the same thing as the catalogues, generally speaking.

Then, in addition to that, Your Honor, I have a
45 collection of labels, J. C. Higgins labels, as used on these various classes of merchandise; all, of course, in the sporting goods department, by Sears, and all showing the name in about the same way, that is, without any emphasis on the surname.

I think that is important.

I proffer all of this material in evidence, Your Honor.

The Court: And you make that proffer through Mr. Downey?

Mr. Marks: Through Mr. Downey.

The Court: Give me your initials, Mr. Downey. What is your full name?

Mr. Downey: G. D. Downey.

The Court: What is your position, Mr. Downey?

Mr. Downey: My major job is chief editor of catalogue advertising.

The Court: Chief editor of catalogue advertising?

Mr. Downey: Yes, that is my major job, to direct the catalogue advertising. Also, I handle all catalogues for the company, both foreign and domestic, and I am the liaison man between the company and our attorneys.

The Court: I did that for the purpose of the record to show who the proffer would be made through.

Mr. Downey: Yes, sir.

Mr. Marks: I have other material, Your Honor.

The Court: All right, sir.

46 Mr. Marks: I have a stipulation of testimony and other formal matters signed by the Solicitor of the Commissioner and myself, and this testimony bears on the adoption of the Higgins name.

The Court: Have you seen this?

Mr. Schimmel: Yes, I have.

The Court: If there is a stipulation, I think I should receive that, sir.

(Stipulation of testimony above referred to was marked Plaintiff's Exhibit No. 2 and received in evidence.)

Mr. Marks: Also I should like to offer in evidence four soft copies of trade-mark registrations—I will read the numbers—which merely cover initials as registered under the 1905 Act, and under the 1946 Act principal register.

I will read these numbers and then I will tell you what my point is.

The numbers are 341,766, dated December 22, 1936, covering the initials "H. C." I don't think we need to go into the goods.

That is the 1905 Act.

And here is one, No. 522-658, dated March 21, 1950, covering initials "G. P." on the principal register of the 1946 Act.

47 Here is one numbered 542-076, dated May 8, 1951, covering initials "H. C." on the principal register of the 1946 Act.

The Court: Would that be a renewal, or anything? You have had the same initials before.

Mr. Marks: They are separate registrations.

The Court: Is the initial in the nature of a renewal?

Mr. Marks: "H. C."?

The Court: Yes.

Mr. Marks: It is different goods and a different concern, Your Honor.

The Court: All right.

Mr. Marks: A different registrant and different goods. One is for chains and this one is for arctics, and so forth.

And the last one is 547-802, dated September 11, 1951, covering initials "G. P." on the principal register of the 1946 Act.

Now, of course, my point in calling these to Your Honor's attention is—I think the Court can accept these as public documents.

You have no objection?

(There was no response.)

Mr. Marks: My point is that if those initials are registerable in and of themselves, without anything else under the 1905 Act and certainly under the 1946 Act
48 principal register, with no reference to Section 2 (f),

I don't see how the registerability of initials can be detracted from by the addition of a name, the name plus the initials.

That is my point of offering it.

Mr. Schimmel: May I raise an objection to the introduction of those as immaterial and irrelevant to this case?

The Court: Yes, sir.

I am going to hold that these are not relevant, sir, and you may take exception if you want, as to the use of the initials.

Mr. Marks: I note an exception.

(Four copies of trade-mark registrations, previously referred to, were marked Plaintiff's Exhibit No. 3 for identification.)

The Court: Does that constitute your proffer, sir?

Mr. Marks: I think that covers all of our evidentiary material, Your Honor.

The Court: Now, let me ask you, Mr. Schimmel: Are you in a position to agree or disagree with what has been proffered?

Mr. Schimmel: Well, certainly I think as to all the advertising by Sears Roebuck in their own catalogues, in the daily press, in the magazines, in their own labels, that they

have no relation to what they said they would prove by this particular submission.

The Court: I did not hear what you said.

49 Mr. Schimmel: They have no relation to what it was suggested that this material might prove, that the general public recognizes "J. C." as part of a trade-mark. That is the plaintiff's own publication, and what the plaintiff may do certainly has nothing to do with what the general public considers it to be.

The Court: I would expect Sears to make the maximum use of anything they sought a trade-mark for.

Mr. Marks: Your Honor, it shows the way the mark is presented to the public and, after all, the public learns of a trade-mark only in the way that it is presented by the trade-mark proprietor.

Mr. Schimmel: There is no issue as to that.

Mr. Marks: Yes, but that is the crux of the case.

The Court: I will hear anything further you have got to say, sir. I am just trying to see where Mr. Schimmel stands at the present time. I will come back to you, sir.

What else do you want, Mr. Schimmel?

Mr. Schimmel: As to the other items, considering what plaintiff's counsel was proposing to prove by this evidence, it strikes me—we have nothing at all to indicate what proportion of the public, for example, has been influenced in this particular case to consider the whole name of the trade-mark just because a few orders may have been received over a period of years—as far as this is concerned, covering six years.

50

Mr. Marks: May I answer that, Your Honor?

The Court: Yes, I will give you a chance. I will come back to you.

Mr. Schimmel: So, basically it seems to me this is completely incompetent insofar as the proffer is concerned, to get a little sampling to say what the public recognizes, and in addition I might say this, that essentially the case involves, as I see it, and primarily nothing but that, the in-

terpretation to be placed on that language. That is for Your Honor to decide in this particular case, and whether or not the Office's interpretation is reasonable under the circumstances, and the fact that someone else may consider the mark or the language to mean something else, I say has no relation to the issues involved in this case. And I see no room for any evidence of that sort, regardless of what it may be.

The Court: All right.

Mr. Marks: Well, Your Honor, I am prepared to show from Mr. Downey just the extent of this advertising, the geographic distribution, the numbers circulated, and so on. In other words, I am prepared to present to Your Honor the entire picture.

Now, as I said before, I think it is extremely important to show how this mark is presented to the public;
51 not only the advertising but on the goods themselves as well as the labels.

In other words, Your Honor is interested in knowing do we feature the surname or don't we. Do we come within the exception mentioned by Mr. Daniels, of playing down everything but the surname and featuring that, or don't we.

The Court: Wouldn't this Act be applicable to a trade-mark which was born with the company coming into being and the test would have to be made as to whether on its face or not it conformed or did not conform with (e), wouldn't it?

Mr. Marks: On its face?

The Court: Yes, sir. What I am saying to you is, isn't the test as to (e) to be made of what use is made of this trade-mark, or isn't that sometimes introductory to the use?

Mr. Marks: As I understand Section 4915, Your Honor, it is designed to permit an applicant to a trial de novo.

The Court: You don't have to argue that, sir. I agree with you.

Mr. Marks: To present the entire picture to the Court.

The Court: That is right. But, of course, subject to the other rules, too.

Mr. Marks: That is true.

The Court: As to the cases.

Mr. Marks: I said at the outset, it is primarily a
52 question of law. After all, any lawsuit involves questions of law.

The Court: In other words, you have, however, made a proffer of the things which you deem material to your case?

Mr. Marks: I have.

The Court: All right, sir.

I will deny the receipt of those in evidence because I do not believe them to be material to the interpretation of what I have to make here.

So, you are clearly protected on the record. If I be wrong, it is on the face of the record.

Mr. Marks: All right. I note an exception.

* * * * *
54 Mr. Schimmel: I should formally offer our folder in evidence.

The Court: Yes, sir. The full file, sir?

55 Mr. Schimmel: Yes, the one containing the print of the drawing and the Examiner's statement and the decision of the Examiner.

The Court: No objection to that?

Mr. Marks: No.

The Court: It will be received.

(Patent Office folder, containing print of drawing and Examiner's statement, together with decision of Examiner, was Defendant's Exhibit No. 1 and received in evidence.)

Mr. Tashof: May we offer those in evidence, or are they sufficiently in evidence now?

The Court: I understand that you have introduced as your Exhibit No. 1, Mr. Marks, the whole file.

Mr. Marks: That is correct, Your Honor.

Mr. Tashof: And the other exhibit, the packet of matches.

Mr. Marks: Would Your Honor receive that in evidence?

Mr. Schimmel: I have no objection.

The Court: It will be received, then. The packet of matches.

(The packet of matches referred to was marked Plaintiff's Exhibit No. 4 and received in evidence.)

Mr. Tashof: And the paper bearing the 1946 quotations from those two Acts, that we had before you there.

56 Mr. Marks: Well, they are merely for His Honor's assistance.

The Court: No, that is the Act of Congress.

Mr. Tashof: How about the pages of the phone book?

The Court: Have you any objection?

Mr. Schimmel: I object to that. I think it has no relevancy. I object to it.

Mr. Marks: His Honor can take judicial notice of that. It does not have to be proven.

Mr. Schimmel: Well, that is something else.

Mr. Marks: I mean compared with the phone book in His Honor's office.

Mr. Schimmel: If the Court wants to take judicial notice of that, it is all right with me.

Mr. Marks: But I think it is of evidentiary value of showing how people are identified by initials as well as by names.

Mr. Tashof: How about the stipulation?

The Court: Well, the stipulation, there is no objection to that and that has been marked Plaintiff's Exhibit No. 2.

Mr. Schimmel: No objection to that.

The Court: And the matches will be Plaintiff's Exhibit No. 4.

57 Mr. Schimmel: I don't think there is any issue as to how people call themselves. They can call themselves anything they want to. There is no argument on that score. If I want to call myself Greek, I can do so, but that has nothing to do with the issues on this case.

The Court: I will sustain the objection to that, and we will mark this for identification Plaintiff's Exhibit No. 5.

(Photostatic copy of pages from Washington Telephone Directory, dated November, 1951, were marked Plaintiff's Exhibit No. 5 for identification.)

Mr. Tashof: How about the exhibits that we proffered. Do they get numbers?

The Court: I don't think you need to do that. It is the scope of your testimony which you have offered. That is along the line of it.

Mr. Marks: How are we going to refer to this?

The Court: I think you have referred to it in the record. It has all been reported, sir.

Mr. Marks: Shouldn't they have exhibit numbers for identification?

Mr. Schimmel: They were excluded.

Mr. Marks: I mean for identification, for reference in the Court of Appeals.

The Court: Have you identified them sufficiently on the record?

58 Mr. Marks: I have identified them.

The Court: All right, sir, let's let it go at that, then.

I assume that you have identified them to the extent that you want them, and for the purpose for which you want them.

Mr. Tashof: Could we give them numbers and then it would be clear?

The Court: I don't see that there is any need for numbering them.

You know exactly what you are speaking of.

* * * * *

III.

EXHIBITS

Excerpts from Plaintiff's Ex. No. 1



**REPEATING
SHOTGUN**

6 SHOTS IN 5 SECONDS

_____ GAUGE _____ BARREL _____ CHOKE

Tested design...modeled on a famous
action that has proved itself through
years of reliable service.

- Walnut Stock
- Visible Lock
- Convenient Safety

CASH PRICE	DOWN
	PER MONTH
	PLUS CARRYING CHARGE

J. C. HIGGINS HUNTING EQUIPMENT IS
SOLD ONLY BY SEARS, ROEBUCK AND CO.

J. C. HIGGINS

Mail Division Feb 5 1948 U.S. Patent Office

Application No. 548852

Hon. Commissioner of Patents
Washington, D. C.

STATEMENT

Sears, Roebuck and Co., a corporation duly organized under the laws of the State of New York and having its principal place of business at 925 South Homan Ave., Chicago, Illinois, has adopted and used the trade-mark shown in the accompanying drawing for Shotguns, Rifles, Gun Sights, Gun Cases, Ammunition Belts in class 9 (Explosives, Firearms, Equipment, etc.) and presents herewith five specimens (or facsimiles) showing the trade-mark as actually used in connection with such goods, the trade-mark being applied to printed tags attached to the goods and requests that the same be registered in the United States Patent Office on the Principal Register in accordance with the Act of July 5, 1946.

The trade-mark was first used on January 15, 1946 for Shotguns; on January 15, 1947 for Rifles; on June 27, 1947 for Gun Sights, Gun Cases, Ammunition Belts and first used in commerce among the several states which may lawfully be regulated by Congress on the respective dates aforesaid. Attached hereto is a letter of permission from John Higgins, who authorized applicant's first use of the trade mark in 1908.

DECLARATION

C. E. Humm, being duly sworn, deposes and says that he is the Secretary of Sears, Roebuck and Co., the applicant named in the foregoing annexed statement, that he believes that said corporation is the owner of the trade-mark which is in use in commerce among the several states and that

no other person, firm, corporation or association, to the best of his knowledge and belief, has the right to use such trade-mark in commerce which may lawfully be regulated by Congress, either in the identical form thereof or in such near resemblance thereto as might be calculated to deceive, that the drawing and description truly represent the trade-mark sought to be registered, that the specimens (or facsimiles) show the trade-mark as actually used in connection with the goods, and that the facts set forth in the statement are true.

POWER OF ATTORNEY

The undersigned hereby appoints S. J. Collons and Frank H. Marks, both of 120 S. LaSalle Street, Chicago, Illinois, Registration Nos. 13,533 and 13,109, its attorneys each with full power of substitution and revocation to prosecute this application for registration, to transact all business in the Patent Office connected therewith, and to receive the certificate.

SEARS, ROEBUCK AND Co.
By C. E. HUMM

CEH

Secretary

STATE OF ILLINOIS

County of Cook, ss

Before me personally appeared C. E. Humm to me known to be the person described in the above application for registration, who signed the foregoing instrument in my presence, and made oath before me to the allegations set forth therein, on the 23d day of October, 1947.

MARGARET WELSH
Notary Public

F53775

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

Paper No. 1 Mailed Aug 31 1948

Address only
The Commissioner of Patents
Trade-Mark Operations
Washington 25, D. C.

All communications respecting
this application should give the
serial number, date of filing,
and name of the applicant.

Please find below a communication from the EXAMINER
in charge of this application.

LAWRENCE C. KINGSLAND
Commissioner of Patents.

S. J. Collons & Frank H. Marks
120 S. LaSalle St.
Chicago, Ill.

Division: TM 6, Room 6823
Applicant: Sears, Roebuck & Co.
Serial No. 548,852
Filed Feb. 5, 1948
For Trade-Mark

Registration is refused in view of T.M. 415,944 Higgins
Industries, Inc., registered August 21, 1945.

The consent on file is not acceptable since it does not in-
clude consent to register. Also, while such a consent meets
the prerequisite to consideration set up in Section 2(c), if
the mark, as here, consists of a word primarily and merely

a surname, it must still qualify either under section 2(F) or the Supplemental Register when evaluated on its merits.

J. R. STERBA
Examiner

(J. C. HIGGINS)

MGS:km
MGS

A proper response to this Office action must be received within 6 months from the date of this action in order to avoid the question of abandonment.

Sears, Roebuck and Co.,
925 S. Homan Ave.,
Chicago 7, Ill.

Gentlemen:

This will confirm that, while employed as an executive of your Company in 1908, my name was adopted, with my permission, by the sporting goods department as a trade mark for baseball supplies. The name applied to the merchandise is "J. C. Higgins."

This name has been used continuously by your firm since that time, having been extended to other items with my approval.

This letter is your authority to continue the use of "J. C. Higgins" as a trade mark for sporting goods and any other items of merchandise to which you may wish to extend said trade mark.

Very truly your,

JOHN HIGGINS

(Date) October 2nd 1947

STATE OF ILLINOIS

County of Cook, ss

Before me personally appeared John Higgins to me known to be the person described in the foregoing statement, who signed the foregoing instrument in my presence, and made oath before me to the allegations set forth therein, on the 2nd day of October, 1947.

MARGARET WELSH
Notary Public

IN THE UNITED STATES PATENT OFFICE

Mail Division Feb 23 1949 U.S. Patent Office

Trade Marks Feb 25 1949 U. S. Patent Office

Application of

SEARS, ROEBUCK AND CO.

Serial No. 548,852

Filed: February 5, 1948

For: Trade Mark "J. C. HIGGINS"

TM Division 6
Room 6823

RESPONSE

Commissioner of Patents

Washington 25, D. C.

Sir:

In response to the Official action dated August 31, 1948, reconsideration is requested in view of the photostat enclosure of another letter of consent from John Higgins addressed to the Applicant and expressing consent to register, as well as to use the trade mark covered by this application. This letter overcomes the objection expressed in the Official action.

Also enclosed is photostat of letter from Higgins Industries, Inc., owners of Trade Mark Registration 415,944,

giving consent to Applicant's use and registration of the instant trade mark, said Registration 415,944 being cited against Applicant's mark as the principal basis of rejection.

It is believed that the Examiner is in error when he states that the mark must still qualify under either Section 2 (f) or the Supplemental Register. If the Examiner will carefully read Section 2 (c), he will see that registration on the Principal Register of a mark which "consists of or comprises a name, portrait, or signature identifying a particular living individual" is prohibited "except by his written consent." Otherwise stated, the name or signature of a living individual *may* be registered on the Principal Register when his consent is given, as in the instant case.

Upon reconsideration, therefore, it is believed that the Examiner's refusal to register on the Principal Register should be withdrawn.

As to the Higgins Industries' citation, same should be withdrawn in view of the attached letter of consent.

For the reasons stated, it is believed that this application should be passed to issue forthwith. Such action is respectfully solicited.

Respectfully submitted,

FRANK H. MARKS,
Attorney for Applicant.

FHM/jb
Encls. (2)
Chicago, Illinois
February 21, 1949.

HIGGINS
INCORPORATED, NEW ORLEANS

February 3, 1949.

Sears, Roebuck & Co.,
Chicago, Illinois.

Attn: Mr. G. D. Downey, Dept. 744.
Subj: "J. C. HIGGINS" trade-mark.

Gentlemen:

Replying to your letter of December 20th, 1948, inquiring if we would have any objection to your applying for the registration of the "J. C. Higgins" trade-mark, under the new Lanham Act.

In view of the fact that you have been using the "J. C. Higgins" trade-mark in connection with sporting goods and hunting equipment, etc. for the past 41 years, and as we can foresee no conflict between your trade-mark and that of our "Higgins", we are agreeable to your filing application for your trade-mark.

Very truly yours,

HIGGINS, INC.,
ANDREW J. HIGGINS,
President.

ajh/ewp

cc—Montgomery, Fenner & Brown, N.O.La.

Mr. Michael Macheca, Office.

POL-89

PAPER NO. 3

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

Please find below a communication from the Examiner in charge of this application.

LAWRENCE C. KINGSLAND
Commissioner of Patents.

Mar 24 1949

S. J. Collons & F. H. Marks
120 S. LaSalle Street
Chicago, Ill.

Division: TM 6 - Room 6220
Applicant: Sears, Roebuck & Company
Serial No. 548,852
Filed February 5, 1948
For Trade-Mark

Restrictions with regard to registering surnames are set forth in two subsections of Section 2 namely (c) and (e) (3).

Applicant has complied with one prerequisite applicable to its mark and has by the letter from J. C. Higgins passed the first hurdle.

The restriction as to a mark being primarily merely a surname sets up entirely new criteria. The mark may be the name of a living person, a dead person, or even a non-existent fanciful person. If it is clearly a surname, it must come under Section 2f.

Marks which are primarily merely a surname which have not become distinctive under Section 2f are subject to registration on the Supplemental Register when the requirements of Section 2c are met.

J. R. STERBA
Examiner

(J C HIGGINS)

MGS:fm

M G S

A proper response to this Office action must be received within 6 months from the date of this action in order to avoid the question of abandonment.

Mail Division
Apr. 19 1949
U.S. Patent Office

TM #4
Arg.

Trade Marks
Apr. 20 1949
U.S. Patent Office

IN THE UNITED STATES PATENT OFFICE

Application of
SEARS, ROEBUCK AND CO. :
Serial No. 548,852 : TM Division 6
Filed: February 5, 1948 : Room 6220
For: Trade Mark J. C. HIGGINS :

RESPONSE

Commissioner of Patents
Washington 25, D. C.

Sir:

This is in response to the Official action dated March 24, 1949.

Reconsideration is requested for the Examiner's repeated refusal to register because of his interpretation of Section 2 (c) and 2 (E)(3) regarding surnames.

Section 2 (c) provides that no trade mark shall be refused registration unless it—

“(c) Consists of or comprises a *name*, portrait, or signature *identifying* a particular living in-

dividual *except by his written consent*, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow."

As pointed out in our previous argument, it is not believed that this section prohibits registration of the mark here at bar for the reason that the name "J. C. HIGGINS" is the name of a living individual whose consent has been given on the record to Applicant's use and registration thereof. *The Examiner has not answered this argument.*

Section 2 (e)(3) contains the following prohibition, i.e.:

"(e) Consists of a mark which (3) is primarily a surname."

Webster's New International Dictionary, Second Edition, defines the word "surname" as follows:

"A name or appellation added to the baptismal or Christian name, and become a family name. Surnames orig. noted occupation, estate, place of residence, or a thing or event relating to the person; thus,

Edmund *Ironsides*; Robert *Smith*, or the *smith*; William *Turner*. Surnames are often patronymics; as, John *Johnson*." (Words here underscored are italicised in the dictionary.)

It appears, therefore, that the Examiner is taking a position which is contrary to the above definition, which is the principal standard of usage of the English language in the United States. The Examiner apparently is reading the mark as if the initials were not there. It is submitted that the Examiner is not justified in disregarding this important part of the mark, which takes it completely outside of the prohibitions of the statute.

Furthermore, we find no justification for the Examiner's position in the reported decisions either before or after adoption of the 1946 Act. It is here pointed out that the

Examiner has omitted to refer to any authority for his position.

In all the cases which we have been able to find involving personal names, we have been unable to find any authority in support of the Examiner's rather peculiar interpretation of the statute and disregard of the dictionary. We do find decisions in support of our interpretation, as set forth above. For example:

Ex parte Sonn Gloves, 73 P.Q. 530 (1947). The word "Sonn" was held by Commissioner Frazer to be a surname not distinctively applied.

Ex parte Cherry-Burrell Cororation, 74 P.Q. 237 (1947). Commissioner Frazer held the word "Vogt" to be "a surname" and has no other meaning and, hence, not registrable under the 1905 Act.

Ex parte Square D Company, 74 P.Q. 306 (1947). Commissioner Frazer held the word "Sard" registrable under the 1905 Act, because, although a surname, "it is rarely so used" and has a dictionary meaning. Hence, the mark at bar "was not merely the name of an individual."

Ex parte Wilson Brothers, 79 P.Q. 429 (1948). Commissioner Daniels held the mark "The Elliott" not registrable under the 1905 Act on the ground that "Elliott" was a surname not distinctively displayed.

Summarizing, we find no case involving a personal name which has been refused registration on that ground, except where the name consisted merely of the family name or surname, as the word "surname" is defined in the dictionary.

It is requested that the Examiner promptly pass this case to publication, or, in the alternative, complete the record by stating fully the authority for his refusal to register and accord this case *final* action, in order that an appeal may be filed and an early and final decision on this point may be

reached, in view of the fact that, as the Examiner knows, this Applicant has a large number of cases involving the same question.

Respectfully submitted,

FRANK H. MARKS,
Attorney for Applicant

FHM/jb

Chicago, Illinois
April 15, 1949

POL-89

PAPER NO. 5

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

Mailed
May 27 1949

Please find below a communication from the Examiner in charge of this application.

LAWRENCE C. KINGSLAND
Commissioner of Patents.

S. J. Collons and
Frank H. Marks
120 S. LaSalle Street
Chicago, Ill.

Division: TM 6 - Room 6220
Applicant: Sears, Roebuck & Co.
Serial No. 548,852
Filed February 5, 1948
For Trade-Mark

In Ex parte Wilson Brothers 79 U.S.P.Q. 429 the Commissioner of Patents decided the addition of the word "The" made no difference and held that the mark was a surname under the 1905 Act, the wording of which is

similar to the 1946 Act except for the addition of "primarily".

The Commissioner said:

"In this connection applicant emphasizes the fact that the word "The" appears in its specimens and drawing. The addition of the article "the" to an unregistrable mark does not appear to give it any added significance, nor is any case called to my attention which would justify registration because of its inclusion".

Addition of the word "primarily" does not, in the opinion of the Examiner, justify any change in the evaluation of such surname plus marks.

J. C. Higgins is primarily nothing but a surname. Secondly it is (a) the name of a living person and (b) a trade-mark used by Sears, Roebuck and Company.

There follow these conclusions:

1. Because it is primarily merely a surname the mark comes under the restriction to registration of surnames mentioned in section 2(e)(3).
2. Because it is the name of a living person, the formalities of section 2(c) apply.

A proper response to this Office action must be received within 6 months from the date of this action in order to avoid the question of abandonment.

May 27 1949
Mailed

3. Because the mark has attained secondary significance, it is eligible for registration under section 2(f).

In accordance with applicant's request, this action is made final.

As presented, registration is refused.

(J C HIGGINS)
MGS:jb
M G S

J. R. STERBA
Examiner

Mail Division
Nov 25 1949
U.S. Patent Office

Trade Marks
Nov 25 1949
U.S. Patent Office

IN THE UNITED STATES PATENT OFFICE

Application of

SEARS, ROEBUCK AND CO.

:

Serial No. 548,852

:

TM Division 6

Filed: February 5, 1948

:

Room 6220

For: Trade Mark J. C. HIGGINS

:

Commissioner of Patents

Washington, D. C.

Sir:

Responsive to the Official action dated May 27, 1949:

Attention is called to the decision of Commissioner Daniels dated November 3, 1949, in *Ex parte Dallieux*, 83 P.Q. 262, reversing the Trade Mark Examiner and holding that a full personal name should not be refused registration on the Principal Register under the 1946 Act, as the same is *not* "primarily merely a surname" and hence does not come within the prohibition of Section 2 (e)(3) of the Act.

Said decision is determinative of the issue herein. It is accordingly requested that this application be passed to publication forthwith.

Respectfully submitted,

FRANK H. MARKS,

Attorney for Applicant

FHM/jb

Chicago, Illinois

November 23, 1949

POL-89

PAPER NO. 7

Mailed

Feb 1 1950

DEPARTMENT OF COMMERCE
UNITED STATES PATENT OFFICE
WASHINGTON

Please find below a communication from the Examiner in charge of this application.

JOHN A. MARZALL
Commissioner of Patents.

S. J. Collons and
Frank H. Marks
120 South La Salle Street
Chicago, Illinois

Division: TM 6 - Room 6220
Applicant: Sears, Roebuck and Co.
Serial No. 548,852
Filed February 5, 1948
For Trade-Mark

A full personal name should not be refused registration on the Principal Register under the 1946 Act. Applying this ruling, set forth and very clearly delimited as to scope in the Dallieux decision, to the present application, the question is presented: Is the designation "J C Higgins" the "entire name of an individual" or is it "a mere device or contrivance to evade the law and secure the registration of nonregistrable words"?

It is the opinion of the Examiner that the surname Higgins is such a predominant portion of applicant's mark

that it comprises "the only significant part of the mark".

Accordingly registration is refused under section 2(e)(3) of the Act of July 5, 1946 by the mandate of the decision in Ex parte Andre Julien Dallieux, 171 Ms.D. 563; 83 U.S.P.Q. 262; 629 O.G. 879 decided November 3, 1949. Upon these grounds the final rejection is adhered to.

J. R. STERBA
Examiner

(J C HIGGINS)
MGS:jb
M G S

A proper response to this Office action must be received within 6 months from the date of this action in order to avoid the question of abandonment.

Mail Division
Jul 29 1950
U.S. Patent Office

Docket Division
Aug 2 1950
U.S. Patent Office

IN THE UNITED STATES PATENT OFFICE

Application of
SEARS, ROEBUCK AND Co. :
Serial No. 548,852 : TM Division 6
Filed: February 5, 1948 : Room 6220
For: Trade Mark J. C. HIGGINS :

APPEAL TO THE COMMISSIONER

Commissioner of Patents
Washington 25, D. C.
Sir:

Appeal is hereby taken to the Commissioner from the final rejection dated February 1, 1950, by the Trade Mark

Examiner of the above entitled application, for the following reasons:

1. The Trade Mark Examiner erred in holding that Applicant's trade mark "J. C. HIGGINS" is "primarily merely a surname."

2. The Examiner erred in holding that the surname "HIGGINS" is such a predominant portion of Applicant's mark that it comprises "the only significant part of the mark."

3. The Examiner erred in finally refusing registration of Applicant's mark.

A check in the amount of \$25.00 in favor of the Commissioner of Patents covering the appeal fee is forwarded herewith.

An oral hearing is desired.

Respectfully,

FRANK H. MARKS,
Attorney for Applicant

FHM/jbs

Enc.

Chicago, Illinois

July 27, 1950

MGS:om.

[Examiner's Statement appears below as part of Defendant's Exhibit No. 1]

[Decision of Examiner-in-Chief appears below as part of Defendant's Exhibit No. 1]

APPLICATION
No. 548852

ACT OF 1946

JCHiggins

PROPRIETOR.
SEARS, ROEBUCK and CO.

Paper No. 10.

Mailed

Aug 23 1950

Defendant's Exhibit No. 1

IN THE UNITED STATES PATENT OFFICE

Applicant: Sears, Roebuck and Co.

Serial No. 548,852, filed Feb. 5, 1948.

Trade-mark for Shotguns, Rifles, Gun Sights, etc.

Attorneys: S. J. Collons and

Frank H. Marks,
120 S. LaSalle Street,
Chicago, Illinois.

Before the COMMISSIONER on Appeal

Examiner's Statement

This is an answer to the appeal taken from the Examiner's refusal to register the mark "J. C. Higgins" on the ground that such mark is primarily merely a surname within the intended meaning of section 2(e) (3) of the Act of July 5, 1946.

Applicant and the Examiner agree that "Higgins" alone would not be registrable except under section 2(f) of the Act. The issue is drawn on the effect and significance of adding the initials J. C. to the name "Higgins".

It is the Examiner's contention that adding two initials to the name does not change it from a surname to an arbitrary mark. The word is still primarily a surname and remains merely a surname until at least another name is added to it at which point it becomes a full name. Thus viewed the initials are similar to addition of the word "the" which was held to have no effect on the mark presented in *Ex parte Wilson Brothers*, 79 U.S.P.Q. 429. This case was decided under the Act of March 20, 1905, but re-

solved the same problem that is presented here, the slightly different wording of the old Act notwithstanding.

Ex parte Dallieux, 83 U.S.P.Q. 262; 629 O. G. 879 is relied upon by both parties to this appeal. The Examiner believes that the mark presented in this application falls into the category mentioned in the obiter dicta portion of that decision, namely, one in which the surname constitutes the only significant part of the mark. Accordingly, the refusal to register the name without a showing of distinctiveness is believed to be proper.

Respectfully,

J. R. STERBA
Examiner.

Docket Division
Dec 12 1950
Copy Mailed

Decision

Hearing:
October 19, 1950

#14
NLS

In the United States Patent Office

Ex parte Sears, Roebuck and Co.

Vol. 173, Page No. 74

Appeal

Application for registration of a trade-mark on the Principal Register under the Act of 1946, for shotguns, rifles, gun sights, gun cases, ammunition belts, filed February 5, 1948, Serial No. 548,852.

S. J. Collons and Frank H. Marks for applicant.

Applicant appeals from the refusal of the examiner to register the mark "J C Higgins" for "shotguns, rifles,

gun sights, gun cases, ammunition belts," on an application filed February 5, 1948, for registration on the Principal Register under the Trade-Mark Act of 1946. The mark is written in a conventional script without periods and is asserted to be the name of a particular individual.

The examiner's position is that the mark can not be registered in view of section 2 (e) (3) of the Trade-Mark Act of 1946 which provides that

"No trade-mark . . . shall be refused registration on the Principal Register on account of its nature unless it . . . (e) consists of a mark which . . . (3) is primarily merely a surname."

The applicant does not question that "Higgins" alone would be unregistrable in view of this clause of the Act, but maintains that this clause does not prohibit the registration of the full name of an individual, and that a surname with initials may constitute the full name. The examiner's position is that adding the initials to a surname does not change it from a surname to an arbitrary mark; the mark is still primarily a surname and remains a surname until at least another name is added to it. The examiner maintains that the addition of initials is similar to the addition of the word "The" which was held to have no effect in *Ex parte Wilson Brothers*, 620 O.G. 1270, 79 U.S.P.Q. 429.

The examiner acknowledges that the mark presented could be registered under section 2(f) of the Trade-Mark Act, which provides that marks which are excluded by subsection 2(e) may nevertheless be registered if they have "become distinctive of the applicant's goods in commerce," which section also provides for a mode of proof of distinctiveness of the mark. While applicant stated at the hearing that the facts were such that it could qualify for registration under section 2(f), nevertheless, applicant does not choose to do so, and consequently it can not be taken that unregistrable matter has become distinctive of applicant's goods nor are any arguments bearing on distinctiveness of any moment.

The status of the registrability of names of individuals under the Trade-Mark Act of 1946 was reviewed by the Assistant Commissioner in *Ex parte Dallieux*, 629 O.G. 879, 83 U.S.P.Q. 262. The Commissioner concluded that, while under section 5 of the Act of 1905, the registration of marks consisting of names of individuals was prohibited generally (with certain exceptions), no such general prohibition appears in the Act of 1946 which, in section 2(e) denies registration to marks consisting merely of surnames, but does not require refusal of registration to a mark consisting of the entire name of an individual. Section 2(c) of the Act of 1946 merely provides, in the case of names of individuals, that registration is to be refused if the mark "consists of or comprises a name . . . identifying a particular living individual except by his written consent . . ." In this case the name is stated to be that of a particular living individual, and his written consent to its registration has been filed. The decision of the Commissioner indicated that the comments made therein would not, of course, apply in the event the surname was unduly emphasized or otherwise constituted the only significant part of the mark, thereby amounting to "a mere device or contrivance to evade the law or secure the registration of nonregistrable words . . .," citing *Beckwith v. Commissioner of Patents*, 252 U.S. 538, 1920 C.D. 471.

It thus appears, as has been decided by the Commissioner, that there is no specific general prohibition in the Act of 1946 of the registration of names of individuals as trade-marks, as there was in the prior Trade-Mark Act of 1905. It does not follow from this, however, that names of individuals have any special status or are entitled to any special consideration over that given to any other trade-mark. As was said by the Court of Customs and Patent Appeals in *The J. B. Williams Co. v. Ernest W. Williams*, 18 C.C.P.A. 1133, 48 Fed. (2d) 398:

"where one elects to make a technical trade-mark use of his own name, that name, for that purpose, becomes

dissevered, as it were, from its owner's personality, and when he seeks to register it under a statutory enactment, it must be tested by precisely the same rules and principles which apply to all other technical trade-marks."

There is no question as to the capability of the mark in this case to function to distinguish applicant's goods, and the specimens accompanying the application and the manner in which the mark is used unquestionably show proper trade-mark use. The only substantial question presented for decision is whether the surname in the combination "J C Higgins" is unduly emphasized or otherwise constitutes the only significant part of the mark so that the mark as a whole can still be characterized as primarily merely a surname.

With respect to this question, I am of the opinion that adding the initials to the surname does not change the mark as a whole from being primarily merely a surname. It is true that initials may be distinctive and may be subject to trade-mark use and registration in and of themselves, but when associated with a surname they become a subordinate and relatively unimportant part of the mark as a whole. While the question here involved was not before the court, the decision of the Court of Customs and Patent Appeals in the decision mentioned above may offer some analogy. In that case the court, reversing the Commissioner of Patents, refused to register the trade-mark "E. W. Williams" (which was presented as a signature, which constituted an exception to the general prohibition in the Act of 1905) of an applicant over the prior registered mark (under the ten-year proviso of the Act of 1905) "Williams" of an opposer, treating the initials as of practically no significance. Attention is also called to *Thaddeus Davids Company v. Davids and Davids*, trading as *Davids Manufacturing Company*, 233 U.S. 461, 1914 C.D. 367, in which the Supreme Court held the trade-mark "Davids", registered under the ten-year proviso of the

Act of 1905, to be infringed by the use of "C. I. Davids," holding the latter to be a mere simulation or colorable imitation of the former. While it is appreciated that these cases were not concerned with the same problem involved here, nevertheless they may both serve as examples indicating the little attention paid to the presence of initials and showing that they are not of any great significance in the trade-mark use of a name. It is accordingly held that the addition of the initials does not change the surname to a mark which is not primarily merely a surname and prohibited registration under section 2(e) of the Trade-Mark Act of 1946.

If it be assumed that the mark as a whole is not primarily merely a surname, it would nevertheless still be unregistrable in the absence of a disclaimer of "Higgins." The word "Higgins" by itself is undeniably primarily merely a surname, and as such cannot be registered under section 2(e). Section 6 of the Trade-Mark Act provides that "the Commissioner shall require unregistrable matter to be disclaimed, . . ." While there presumably must be some degree of discretion in requiring disclaimers under section 6, the situation presented here is that of a word which is categorically barred by the statute from registration (unless under the provisions of section 2(f)), and it is believed that the mark could not be registered as presented unless applicant disclaimed the surname "Higgins" apart from the mark as shown.

The decision of the examiner is accordingly affirmed.

P. J. FEDERICO
Examiner-in-Chief

December 12, 1950

[The hearing and determination of appeals in trade-mark cases have been delegated to the members of the Board of Appeals of the Patent Office by an order of the Secretary of Commerce, published September 28, 1950, 15 Federal Register 6554, and October 17, 1950, 639 O.G. 643, under the provisions of Reorganization Plan No. 5 of 1950, 15 Federal Register 3174.]

SUPPLEMENTAL JOINT APPENDIX

IN THE

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT.

No. 11,454

SEARS, ROEBUCK AND CO., *Appellant*,
ROBERT C. WATSON v.

~~JOHN A. MARZALL~~, Commissioner of Patents, *Appellee*.

Appeal from the United States District Court for the
District of Columbia.

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IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT.

No. 11,454

SEARS, ROEBUCK AND CO., *Appellant*,

v.

JOHN A. MARZALL, Commissioner of Patents, *Appellee*.

Appeal from the United States District Court for the
District of Columbia.

SUPPLEMENTAL JOINT APPENDIX.

75

Filed Mar 18 1952

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1374-51

SEARS, ROEBUCK AND COMPANY, *Plaintiff*

v.

JOHN A. MARZALL, Commissioner of Patents, *Defendant*.**Findings of Fact**

1. This is a civil action under the provisions of Sec. 4915 of the Revised Statutes (35 U.S.C. 63), in which the plaintiff, Sears, Roebuck and Company, seeks a judgment from this Court authorizing the defendant, the Commissioner of Patents, to grant to plaintiff a certificate of registration for the trade-mark "JC Higgins" on the Principal Register of the Trade Mark Act of 1946 (15 U.S.C. 1052), based upon plaintiff's application Serial No. 548,852, filed February 5, 1948, for the registration of such mark on Shotguns, Rifles, Gun Sights, Gun Cases and Ammunition Belts.

76 2. In 1908 plaintiff had in its employ George E. Stoll, then manager of its Sporting Goods Department, and John Higgins, a statistician and director of the company. Stoll conceived the idea of using Mr. Higgins' name as his sporting goods trade-mark, but realizing that John Higgins lacked a middle initial he decided to create the middle initial "C" for Mr. Higgins and use his name in the form "JC Higgins" as a trade-mark, which idea was approved by Mr. Higgins. The mark was thus adopted in the form "JC Higgins" for plaintiff's sporting goods and has been so used ever since.

3. At the time the application at bar was filed on February 5, 1948, said Higgins was still living, and he consented to the continued use of "JC Higgins" by plaintiff and authorized plaintiff to secure registration thereof as

a trade-mark for sporting goods and any other items of merchandise to which plaintiff might wish to extend its use. The letter of consent and approval which appears in the record as an exhibit filed with the complaint is signed "John Higgins", no middle initial being used.

4. Plaintiff has used the mark "JC Higgins" on such goods continuously and up to the present time, the mark being extended to a larger line of merchandise in related fields, since the first adoption thereof. Use since January 15, 1946, is claimed for the specific goods set forth in the application involved in this proceeding.

77 5. The word "Higgins" in the mark "JC Higgins" is merely a surname.

6. The word "Higgins" in the mark "JC Higgins" is the salient, dominant, pre-eminent and clearly noticeable part of the mark.

7. The initials "JC" in the mark "JC Higgins" are an insignificant part of the mark.

8. The mark "JC Higgins" has as its foundation only the surname Higgins and is clearly dominated thereby.

9. The mark "JC Higgins" is primarily merely a surname.

Conclusions of Law

1. The trade-mark "JC Higgins" is not entitled to registration upon the Principal Register established by the Trade Mark Act of 1946, based upon the application at bar, because Sec. 2(e)3 prohibits the registration of a mark which is primarily merely a surname.

2. Since the interpretation to be placed upon the statutory language prohibiting the registration of a mark which is primarily merely a surname is a matter of law, evidence offered to show or explain that the initials "JC" in
78 the mark "JC Higgins" are considered significant by purchasers and customers of plaintiff and therefore that the mark is not within the prohibition of the statute is irrelevant and inadmissible in the case.

3. The plaintiff is not entitled to register the mark here involved on the principal register established by the Trade Mark Act of 1946 based upon the application at bar.

4. The complaint should be dismissed.

R. B. KEECH
Judge

March 18th, 1952

* * * * *

79

Filed Mar 18 1952

Judgment

This action came on to be heard at this term and thereupon upon consideration thereof, it is this 18th day of March, 1952,

ADJUDGED that the complaint be and it is hereby dismissed, with costs against the plaintiff.

R. B. KEECH
Judge

* * * * *

80

Filed Apr 17 1952

Stipulation Re Filing Exhibits Proffered Under Offer of Proof, Rule 43(c)

It is hereby stipulated by and between the parties to the above-entitled action, by their counsel, the Court consenting thereto, that the accompanying exhibits for plaintiff, offered for identification during plaintiff's offer of proof under Rule 43(c), Rules of Civil Procedure for the District Courts, but which were not filed during the trial, may be filed and be included as physical exhibits as a part of plaintiff's offer of proof. The said exhibits are identified in the transcript of the trial proceedings as follows:

Photostat copies of " * * * letters * * * and orders from people writing in to Sears, Roebuck inquiring into and ordering J. C. Higgins merchandise * * * ." (Transcript page 37).

Photostat copies of " * * * three articles * * * (from) nationally distributed periodicals pertaining to sporting goods which mention J. C. Higgins goods." (Transcript page 43).

81 Photostat copies of " * * * an ad sponsored by Sears in 'Field and Stream' of November, 1951, and another one for September, 1951; both of them advertising a J. C. Higgins gun * * * ." (Transcript pages 43 and 44).

Photostat copies of " * * * a representative sampling of Sears catalogues". (Transcript page 44)

Photostat copies of " * * * retail advertising by Sears in the various newspapers * * * ." (Transcript page 44)

" * * * a collection of labels, J. C. Higgins label, as used on these various classes of merchandise; * * * " (Transcript pages 44 and 45).

C. WILLARD HAYES

American Security Building
Washington 5, D. C.

Attorney for Plaintiff

E. L. REYNOLDS, *Solicitor*

United States Patent Office

Attorney for Defendant

Approved and So Ordered:

RICHMOND B. KEECH

United States District Judge

Date: April 16th, 1952

* * * * *

BRIEF FOR PLAINTIFF-APPELLANT.

IN THE
United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA *For the*
District of Columbia Circuit

No. 11,454

FILED SEP 5 1952

SEARS, ROEBUCK AND CO.,

Joseph D. Stewart
Appellant,

ROBERT C.] WATSON vs.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

Appellee.

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

C. WILLARD HAYES,
American Security Bldg.,
Washington, D. C.,

FRANK H. MARKS,
120 South La Salle Street,
Chicago 3, Illinois,
Attorneys for Plaintiff-
Appellant.

September 5, 1952.

The Questions Presented.

(1) The principal question is whether the trade mark J C HIGGINS, which Appellant has used for 44 years for a large line of sporting goods and which is the subject of the pending application for registration in the United States Patent Office involved in this appeal and in 16 other copending applications, and which is admitted by the Patent Office to function as a trade mark to distinguish Appellant's goods, is registrable under Section 2 of the Trade Mark Act of 1946 (Chapter 540, Title 1, Section 2, 60 Stat. 428, 15 U. S. C. Section 1052), or whether registration is prohibited by said section. The pertinent portion of said section reads as follows:

"Sec. 2. No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it * * * (e) consists of a mark which * * * (3) is primarily merely a surname."

(2) A secondary question is whether, in an equity suit against the Commissioner of Patents under Section 4915 R. S., seeking an order to grant registration of a trade mark, a trial judge may properly exclude substantially all of Plaintiff's proofs and refuse to hear the only witness presented by the Plaintiff, on the alleged ground that the evidence is "immaterial," as the case presents "merely a question of law."

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IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA

No. 11,454

SEARS, ROEBUCK AND CO.,

Appellant,

vs.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

Appellee.

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

BRIEF FOR PLAINTIFF-APPELLANT.

JURISDICTIONAL STATEMENT.

(a) This case arises out of the refusal of the Commissioner of Patents to grant a trade mark registration on a particular application filed by Appellant, Sears, Roebuck and Co., under the Act of July 5, 1946. Because of such refusal, Appellant filed a civil action in the United States District Court for the District of Columbia against the Commissioner of Patents pursuant to the provisions of R. S. Section 4915, February 9, 1893, C. 74, Section 9, 27 Stat. 436, 35 U. S. C. Section 63, and Section 21 of the Trade-Mark Act of July 5, 1946, C. 540, Title 1, Section 21, 60 Stat. 435, 15 U. S. C. Section 1071. This appeal is taken under the Act of June 25, 1948, C. 646, Sec. 1, 62 Stat. 929, 28 U. S. C. Section 1291.

(b) In the Complaint (Joint App. 2) it is alleged that Plaintiff, Sears, Roebuck and Co., a New York corporation, on February 5, 1948, filed in the United States Patent Office application Serial No. 548,852 for registration of the trade mark J C HIGGINS for shotguns, etc., said application being one of 17 copending applications to register the same trade mark in various classes for a large variety of articles in the field of sporting goods; that all of the statutory requirements and all of the rules relating to such applications were duly complied with, but that the Patent Office in the person of the Trade Mark Examiner and later in the person of the Examiner-in-Chief acting for the Commissioner, finally refused to grant said application or any of said applications for registration on the alleged ground that the trade mark J C HIGGINS was "primarily merely a surname," the Patent Office officials stating that the HIGGINS portion of the trade mark "comprises 'the only significant part of the mark.'" (Joint App. 47-48.)

(c) The jurisdiction of the District Court is accepted without question in Defendant's Answer (Joint App. 13, par. 1).

STATEMENT OF THE CASE.

In view of the fact that the Trial Judge refused to permit Plaintiff's only witness to be sworn and refused to admit in evidence most of Plaintiff's proofs, even refusing exhibit numbers for identification as to the excluded matter (Joint App. 29), and Defendant offered no proofs at the "trial," the record is substantially devoid of evidence in the usual sense of the word. Our statement of the case must, therefore, necessarily be predicated on the rather unsatisfactory record as the Honorable Court of Appeals finds it.

Plaintiff, Sears, Roebuck and Co., which with its predecessors in business has been operating a retail general merchandise business since 1886, in the year 1908 adopted as a trade mark for sporting goods the notation J C HIGGINS. The "Stipulation of Testimony" (Plaintiff's Ex. 2—Item 5, Designation of Contents of Record on Appeal) states the facts which surrounded the adoption of said trade mark. George E. Stoll, who in the year 1908 was manager of Sears' sporting goods department, was looking for a suitable trade mark in the form of a personal name corresponding in form to "A. G. Spalding," which at the time was achieving success in the sporting goods field. The matter was discussed between Mr. Stoll and A. H. Loeb, vice president of Sears, and they decided on the name of JOHN HIGGINS, then a director of the Company. Finding that Higgins lacked a middle initial, they decided to give him one and created the name of J C HIGGINS which was thereupon adopted as the trade mark, with the consent of Mr. Higgins, and the name "has been used in that form ever since" (Stipulation of Testimony, p. 2) and gradually extended to include a long line of sporting goods. (See match book, Plaintiff's Ex. 4.)

In a verified statement of Higgins himself, who was living at the time of filing the application here involved and the other 16 J C HIGGINS applications, he stated (Joint App. 8), "My name was adopted with my permission * * * the name applied to the merchandise is J C HIGGINS."

The trade mark has always been used by Appellant in the form J C HIGGINS as shown in the large assortment of labels offered in evidence (Designation of Record, Item 18; Joint App. 22), the entire mark being written in letters of equal size and prominence in script form resembling a signature, although not actually a signa-

ture; likewise, in Appellant's advertising the mark J C HIGGINS has always been presented as a complete unit consisting of the surname and the initials, usually in the same script form as on the labels but frequently in block letters with periods following the initials (Designation of Record, Items 15, 16 and 17; Joint App. 21-22).

Appellant filed its application to register its J C HIGGINS trade mark for certain items in Class 9, Explosives, firearms, etc., on February 5, 1948, Serial No. 548,852, and copending with said application are 16 additional applications covering the same trade mark for a large variety of sporting goods in other Patent Office trade-mark classifications. All of said applications request registration of the J C HIGGINS trade mark on the Principal Register of the 1946 Act without recourse to Section 2(f).

All of said applications have been finally refused registration as filed on the alleged ground that the mark J C HIGGINS is "primarily merely a surname" and therefore said to be barred by Section 2(e)(3) of said act, the Examiner holding, and it being affirmed by the Patent Office Examiner-in-Chief acting for the Commissioner, that the name HIGGINS "comprises 'the only significant part of the mark.'" (Joint App. 47-48.) This view is concurred in by the Trial Court, Findings 6-9.

The Patent Office acknowledges that Appellant's mark J C HIGGINS qualifies as a trade mark identifying Appellant's goods and hence would be registrable under Section 2(f), Joint App. 55, last par.; see Joint App. 16:

"Mr. Schimmel (Solicitor for the Patent Office): The appeal decision—the statement is made: 'There is no question as to the capability of the mark in this case to function and distinguish applicant's goods, and the specimens accompanying the appli-

cation in the manner in which the mark is used unquestionably shows trade-mark use.'

"It is not in issue here."

Pursuant to the final refusal of registration by the Trade Mark Examiner, affirmed by the Examiner-in-Chief acting for the Commissioner, this action was filed in the District Court under R. S. 4915 seeking an order to direct the Commissioner to grant the registration, it being understood that a decision in the one application would be applicable to all 17 copending cases, as the identical question is presented in all.

At the "trial" Plaintiff was prepared to present in evidence certain documentary material through an employee of Plaintiff, G. D. Downey, who was brought to Washington especially to testify in the case. Ruling that the case presented merely a question of law, the Trial Judge refused to permit the witness to be sworn and refused to accept any of the evidence offered by Plaintiff except a certified copy of the file wrapper of the application (Plaintiff's Ex. 1; Joint App. 14), a stipulation of testimony regarding the circumstances of adoption of the trade mark (Plaintiff's Ex. 2; Joint App. 23) and a matchbook advertising J C HIGGINS goods (Plaintiff's Ex. 4, Joint App. 28).

Appellant has no quarrel with Findings of Fact 1-5, inclusive.

STATUTE INVOLVED.

This controversy involves the interpretation of the new Trade Mark Act of July 5, 1946 ("Lanham Act"), Public Law 489, 79th Congress, Chapter 540, 60 Stat. 427, 15 U. S. C. Chapter 22. In this brief said Act will hereinafter be referred to as the Act of 1946 or the 1946 Act.

The particular section of the Act which is in controversy is Section 2 (15 U.S.C. 1052), the pertinent parts of which read as follows:

“Sec. 2. No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it * * * (e) consists of a mark which, * * * (3) is primarily merely a surname.”

STATEMENT OF POINTS.

Point 1. In refusing registration, the prior tribunals overlooked the intent of the 1946 Act, which was to protect the public and the owners of trade marks.

Point 2. The prior tribunals erred in dissecting Appellant's trade mark, and after such dissection, throwing away a major portion of the mark which in itself would be registrable under existing law and practice, namely, the initials J C, and finding that the name HIGGINS alone constituted “the only significant part of the mark.” The Trial Court erred particularly in Findings of Fact 6-9, inclusive.

Point 3. The prior tribunals failed to apply the principle that in case of doubt as to the correct interpretation of the 1946 Act, such doubt should be resolved in favor of the applicant for registration, because, in the event of an improvident decision in the applicant's favor, all persons are fully protected under the 1946 Act by their right to oppose the grant of the registration or, if by inadvertence no opposition is filed, they may file a petition to cancel the registration.

Point 4. The Trial Court erred in refusing to accept the explanation clearly set forth in the Congressional Hearings, explaining in unambiguous language the mean-

ing of the term, "primarily merely a surname," as found in Sec. 2 of the Act, and in treating the initials J C as if they did not exist as a part of the mark.

Point 5. The Trial Court erred in refusing to admit substantially all of Appellant's documentary proofs and in refusing to hear Appellant's witness, offered as bearing on the major point in issue, and further erred in filing Findings of Fact 6-9, inclusive, when there was no evidentiary material accepted in evidence from the Plaintiff, and none even offered by the Defendant, upon which said findings could be based.

Point 6. Each of the prior tribunals failed to apply the principle that where a statutory grant is expressed in general terms, limiting provisos or exceptions should be strictly construed in favor of those persons whom the general statutory grant was intended to benefit.

SUMMARY OF ARGUMENT.

Proposition No. 1.

The "basic purposes" of the Trade Mark Act of 1946 were to protect the public, to enable it to obtain the product it desires, and to protect the trade mark owner against pirates and cheats; also, "to dispense with mere technical prohibitions and arbitrary provisions."

Proposition No. 2.

The sole purpose of the prohibition in Section 2 (e) (3) of the 1946 Act against registration of marks which are "primarily merely a surname" was to protect all persons having a given family name in the right to use their name legitimately, *i.e.*, so that it would not produce confusion, and *to permit the registration of names whose primary significance is not merely that of a surname*, and this meaning was clearly explained to the legislators by the drafters of the section.

Proposition No. 3.

A family name prefixed by two initials, all in type of equal size and prominence, cannot properly be considered "primarily merely a surname," when the trade mark proprietor invariably presents the entire mark (family name and initials) in type of equal size and prominence in its own advertising and in its labels and when the entire name is invariably employed in customer communications and in trade paper references to the goods, and when names of the same type are commonly used to identify telephone subscribers.

Proposition No. 4.

A family name prefixed by two initials, when it is the name of a living individual who consents to its use and registration, referring to it as "my name," cannot properly be considered "primarily merely a surname."

Proposition No. 5.

A composite trade mark should not be dissected into its elements in order to form a basis for refusing registration, but must be considered as a whole; when so considered, J C HIGGINS is not primarily merely a surname.

Proposition No. 6.

The addition to initials, which alone are considered registrable by the Patent Office without recourse to Section 2 (f), of a surname in type of the same size and prominence, does not result in an unregistrable mark.

Proposition No. 7.

Refusal to register the mark J C HIGGINS cannot be justified as protection of the public when a leading industry operating under the trade name HIGGINS, INC., and registrant of the trade mark "HIGGINS" for the same class of goods, sees "no conflict" and consents to Appellant's registration. (Joint App. 39)

Proposition No. 8.

The Patent Office has no right to require a trade mark applicant to accept a registration under Section 2 (f) of the 1946 Act, which provides for registration of an otherwise unregistrable mark upon proof that it has acquired "distinctiveness," when the mark is eligible for registration without recourse to that section. Until Sec-

tion 2 (f) of the new law is thoroughly adjudicated, the legal profession regard it as affording protection of only secondary value.

Proposition No. 9.

A trial court in an equity suit under R. S. 4915 to direct the grant of a trade mark registration, after the Patent Office has ruled that a certain portion thereof is "the only significant part," should not exclude as "immaterial" substantially all of the Plaintiff's proofs offered to establish that the mark is presented by the Plaintiff to the trade and is employed by the trade itself in a manner clearly disproving that construction, *i.e.*, evidence on the point which the Patent Office had made the very *crux of the case*.

Proposition No. 10.

In case of doubt as to the correct interpretation of the 1946 Act, such doubt should be resolved in favor of the applicant for registration, because, in the event of an improvident decision in the applicant's favor, all persons are fully protected under the 1946 Act by their right to oppose the grant of the registration or, if by inadvertence no opposition is filed, they may file a petition to cancel the registration.

Proposition No. 11.

Findings of a trial court should be reversed or modified where clear error appears.

Proposition No. 12.

Where a statutory grant is expressed in general terms, any exception or proviso requires the strictest interpretation, and any doubt should be resolved in favor of one who qualifies under the general grant.

ARGUMENT.

Proposition No. 1.

The "basic purposes" of the Trade Mark Act of 1946 were to protect the public, to enable it to obtain the product it desires, and to protect the trade mark owner against pirates and cheats; also, "to dispense with mere technical prohibitions and arbitrary provisions."

The basic intent of the new Trade Mark Law of 1946 was expressed in identical language in Committee Reports of the House of Representatives and the Senate (H.R. Report No. 603 to accompany H.R. 82, 78th Congress, 1st Session, and Senate Report No. 1303, Calendar No. 1302, to accompany H.R. 82, 78th Congress, 2d Session) under the heading "Basic Purposes of Trade-Mark Legislation," both reports stating:

"The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. * * * Your committee believes the proposed bill accomplishes these two broad basic principles."

The same Committee Reports also contain the following language regarding objectives of the legislation under the caption "Trade-Marks Defeat Monopoly by Stimulating Competition":

"This bill * * * has as its object the protection of trade-marks, securing to the owner the goodwill of his business and protecting the public against

spurious and falsely marked goods. * * * This can be done without any misgivings and without the fear of fostering hateful monopolies, for no monopoly is involved in trade-mark protection,”

citing Trade-mark Cases, 100 U.S. 82; *Prestonettes v. Coty*, 264 U.S. 359; *United Drug Co. v. Rectanus*, 284 U.S. 90, and others.

We further find in the same Committee Reports under the heading “The Statutes” the following statement of objectives for the proposed legislation which became the 1946 Law:

“The purpose of this bill is to place all matters relating to trade-marks in one statute and to eliminate judicial obscurity, to simplify registration and *to make it stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions.* * * * This bill effects this necessary codification and coordination.” (Emphasis added.)

The attitude of the lower tribunals in this case, in applying a strained interpretation of the Act, cannot be reconciled with these clearly expressed objectives of the Legislature.

The Committee Reports express the legislators’ objectives in somewhat more specific language under the heading, “Purposes of the Present Bill,” as follows, *inter alia*:

“3. To modernize the trade-mark statutes so that they will conform to legitimate present-day business practice.

“4. To remedy constructions of the present acts which have in several instances obscured and perverted their original purpose. These constructions have become so ingrained that the only way to change them is by legislation.

“5. Generally to simplify trade-mark practice, to secure trade-mark owners in the goodwill which they

have built up, and to protect the public from imposition by the use of counterfeit and imitated marks and false trade descriptions.”

Section 2(e)(3) is thought to have been in mind in connection with the above, and especially item 4.

Following this itemized statement of objectives, the Committee Report states:

“* * * a sound public policy requires that trademarks should receive nationally the greatest protection that can be given them.”

Proposition No. 2.

The sole purpose of the prohibition in Section 2(e)(3) of the 1946 Act against registration of marks which are “primarily merely a surname” was to protect all persons having a given family name in the right to use their name legitimately, i.e., so that it would not produce confusion, and to permit the registration of names whose primary significance is not merely that of a surname, and this meaning was clearly explained to the legislators by the drafters of the section.

In the light of the above discussion of objectives, we may now compare the language of Sec. 2(e)(3) of the 1946 Act with the corresponding section of the 1905 Act which it supplanted.

As set forth above (p. 2), Section 2(e)(3) of the 1946 Act in substance prohibits registration of a trade mark which “(3) is *primarily merely a surname.*”

In the 1905 Act we find the following language:

“Sec. 5. U.S.C. Title 15, Sec. 85 * * * *Provided*, that no mark which consists merely in the *name of an individual* * * * not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual * * *

shall be registered under the terms of this Act.” (Emphasis added.)

In applying the 1905 Act the Patent Office practice was to refuse registration of *all personal names, i.e.,* full names as well as surnames, unless coming within one of the exceptions of Section 5.

Although it would appear obvious that in the enactment of Section 2(e)(3) of the 1946 Act the Congress intended, in using different language, to enact something different from the name proviso of the 1905 Act, and more especially to *liberalize* said restriction, in view of the statement of objectives found in the legislative history, nevertheless, the Patent Office proceeded for several years after the effective date of the 1946 Act to interpret Sec. 2(e)(3) as if it had *precisely the same significance* as the 1905 proviso, refusing to register complete names as well as surnames.

This state of affairs continued until the question was presented on appeal to the Commissioner of Patents in *Ex parte Dallieux*, 83 U. S. P. Q. 262. The applicant there sought to register as a trade mark the name ANDRE DALLIOUX and the Examiner finally refused registration on the ground that it was “primarily merely a surname” within the prohibition of Section 2(e)(3).

In reversing the Examiner, Assistant Commissioner Daniels pointed out the inconsistency of that official’s position, stating (p. 262):

“To state * * * that the entire mark presented, ‘Andre Dallieux,’ is ‘merely a surname’ is a contradiction, since it comprises the entire name of an individual.” (Not strictly correct, for Applicant Dallieux had a middle name.)

The Commissioner defined the scope of the 1905 Act prohibition, referring to the decision of the Court of Cus-

toms and Patent Appeals in *The American Tobacco Co. v. Wix*, 62 F. 2d 835; 16 U. S. P. Q. 181, 182, which held that that Act prohibited registration of surnames as well as complete personal names, and in comparing the two laws (p. 263) stated, with reference to ANDRE DALLIOUX:

“To refuse registration of the mark as shown in the drawing would be in effect to continue the rule of the Act of 1905, even though the prohibition against registration of a mark consisting of the name of an individual (which included surnames but was not restricted thereto), no longer remains in the law.”

In a further, and we think logical, attempt to interpret the 1946 section, Commissioner Daniels went on (p. 263):

“The foregoing comments would, of course, not apply in the event the surname was unduly emphasized or otherwise constituted the only significant part of the mark, thereby amounting to ‘a mere device or contrivance to evade the law and secure the registration of nonregistrable words * * *’ *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 1920 C. D. 471.”

Following the *Dallieux* decision, the trade mark examiners accepted the Commissioner's mandate to the extent of allowing trade marks which met the *precise pattern* of ANDRE DALLIOUX; in other words, they have registered those trade marks which consist of a surname preceded by a *complete given or Christian name* but have stubbornly refused to deviate from this pattern, seizing as authority for refusing all other names Mr. Daniels' dictum as to cases where “the surname was unduly emphasized or otherwise constituted the only significant part of the mark.”

Thus, we find the following statement of the Examiner in the file history of the instant case (Joint App. 47-48):

“It is the opinion of the Examiner that the surname Higgins is such a predominant portion of ap-

plicant's mark that it comprises 'the only significant part of the mark,' "

his quotation obviously being from the *Dallioux* decision.

Thus, the Examiner is grasping upon a *dictum* of Mr. Daniels and distorting his meaning which is clearly expressed in the final portion of *the same sentence, viz.:*

"* * * thereby amounting to 'a mere device or contrivance to evade the law and secure the registration of nonregistrable words,' "

citing the Supreme Court's *Beckwith* decision. The most casual inspection of Appellant's mark, as shown in the application drawing or labels, shows the utter inapplicability of Mr. Daniels' exception as to where "the surname was unduly emphasized, * * * amounting to 'a mere device or contrivance to evade the law * * * ' "

Inasmuch as Commissioner Daniels made reference to the *Beckwith* decision in connection with the language seized upon by the Patent Office, the Court will be interested in knowing something about that case. Strangely enough, we find that, while the *Beckwith* case was an appeal from the Patent Office in an ex-parte trade mark matter, *it had nothing to do with registration of personal names.* The only question for decision was whether certain descriptive matter which was non-registrable under the 1905 Act should be deleted from the trade mark drawing or merely disclaimed apart from the mark, and the Supreme Court laid down what became the established disclaimer practice.

Hence, we have the interesting situation of Mr. Daniels quoting language which, incidentally, we are unable to find on a careful reading of the case, purporting to come from a Supreme Court decision which had nothing whatever to

do with personal names, and of this language being seized upon by the Patent Office as a supposed basis for a strained interpretation of the name section of the law.

Philosophy of the Beckwith case is applicable.

We do find, nevertheless, that Mr. Justice Clark in the *Beckwith* case expressed a number of principles, in an effort to guide the Patent Office's attitude on trade mark applications, which are directly in point in the instant case, and it would be profitable to quote some of those principles:

"The Registration Act of 1905 * * * without changing the substantive law of trademarks, provided, in the manner prescribed, for the registration of marks (subject to special exceptions) which, without the statute, would be entitled to legal and equitable protection * * *" (64 L. ed. 707)

"* * * the requirement of the statute that *no trade mark shall be refused registration*, except in designated cases, is just as imperative as the prohibition of the proviso against registration in cases specified." (p. 708)

The last quoted rule was considered so important by Mr. Justice Clark that he repeated it in almost identical language in the next column on p. 708.

Substantially the *same statutory language*, "No trade mark * * * shall be refused registration * * * unless," etc., is repeated in Sec. 2 of the 1946 Act.

The Supreme Court continued:

"Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and *this should not be done if it can be avoided by fair, even liberal, construction of the act*, designed, as it is, to

promote the domestic and foreign trade of our country." (p. 708, emphasis added.)

The above was the mandate of the Supreme Court to the Patent Office as to interpretation of the 1905 Act, and we have seen that it was the purpose of the Congress to *liberalize* that law in enacting the 1946 Act.

The attitude shown by the lower tribunals in the case at bar can hardly be said to be in harmony with the spirit of the Supreme Court or of the Congress, as set forth above.

The legislative history shows beyond question that the intended meaning of Section 2(e)(3) was to exclude only names whose primary meaning was "merely a surname."

Reference is made to the Government publication, "Hearings before the Committee on Patents, Subcommittee on Trade-Marks, House of Representatives, Seventy-Sixth Congress, First Session, on H.R. 4744, March 28, 29, 30, 1939." (Government Printing Office, 1939, Doc. 140156). Copy is attached as appendix 3a hereto.

It is interesting to note the historical development of the section which ultimately was enacted as Section 2(e)(3). Thus, on page 18 of the above noted publication, we find the Committee considering the following section.

"Sec. 2. No mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration as a trade-mark on account of its nature unless it * * * (e) * * * is merely the name of an individual *and has no other meaning.*" (Emphasis added.)

Please note—here is the historical antecedent for the word "primarily" as it ultimately emerged in the Act. We also note (same page) that consideration was given

to revising the section to specify “*full* name of an individual.”

We see this Section crystallizing on page 19 of the same Report in the following discussion of Mr. Edward S. Rogers, wherein he combines his thoughts as to both personal and geographic names. (Mr. Rogers, then considered dean of the legal profession in trade mark law, was largely responsible for drafting the new Act.)

“I would like to make a suggestion, and that is that it seems to me the language in subsection (e) is not altogether happy. There is a practical difficulty that is encountered in the Patent Office, and one which has been encountered in every Patent Office in the world, as far as I know, as to what is a geographical name. The present statute prevents the registration of geographical names as trade-marks. Some people take the position that any name is found somewhere in the Postal Guide, and hence is not a registerable name. For instance, Pink, Red, Fish, Green, Greenfield, Lily Pons, and so forth, are all found in the Postal Guide. They are the names of individuals or persons and shall not be registered. There is somewhere on the earth’s surface some person who has any name that you can possibly think of. The result of that is that if literally interpreted that provision in the present act prohibits the registration of nearly any word that anybody can think of. I would suggest that subsection (e) be amended to read this way, and I think it carries out the same idea and, perhaps, makes it a little clearer: * * *

“(3) is merely and primarily the name of a particular person other than the applicant.”

“That is to get away from this idea of a surname. Any name can be a surname, such as Cotton, King, Jack, Knife, Ink, and the like, but it is not the name of any particular person.”

In the session of Wednesday, March 29, 1939 (*Ibid.*, p. 39), we find that the language of Section 2(e)(3) has

evolved to “(3) Is primarily a surname,” which is the final language of the Act except that it lacks the word *merely*.

On page 40, in the course of discussing this Section, Mr. Rogers states:

“The difficulty about that is that almost every word you can think of is somebody’s surname, somewhere, and there has been a practice in the office of the Commissioner of Patents, which was born a number of years ago, that any mark for which registration was applied, which was borne by some person, somewhere as a name such as Cotton, King, or whatnot, they would refuse registration on the ground that they were merely the names of individuals. It is perfectly all right to refuse registration where the name is a name of a particular individual, but where it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice.”

After some colloquy between Mr. Rogers, Mr. Fenning and Mr. Frazer, Assistant Commissioners of Patents, the discussion narrowed down as follows: (*Ibid.*, p. 41)

“Mr. Rogers. Well, if it will meet the objection, and whatever you do, you are going to meet something unfavorable, would this meet the situation: ‘Is merely and primarily a surname’?”

* * *

“Mr. Frazer: Then I would suggest that you leave out the word ‘merely.’”

“Mr. Rogers. Well, Johnson is *primarily* a surname, and Cotton is not.

“Mr. Frazer: Yes; but when you say ‘merely’ a surname, you would prohibit the registration of such names as Cotton and King, as you suggested, Mr. Rogers.

“Mr. Rogers. Suppose we make it read: ‘Is *primarily* a surname’?”

“Mr. Frazer. Yes; I think insofar as the Patent Office is concerned that that would simplify the administration of it.

The above colloquy of the men who drafted the Section in question makes the meaning crystal clear, and it is the natural meaning apparent from the language of the law without requiring the slightest “interpretation”. The Congress wished to broaden the proviso of Section 5 of the 1905 Act, which excluded from registration *all* personal names, both surnames and full personal names, unless printed or woven in a peculiar manner or in association with a portrait, *to permit registration of all personal names except words whose primary significance was merely a surname*, such as Johnson. This meaning is clearly apparent from the remarks in connection with insertion of the word “primarily”.

Commissioner Daniels perceived all this when he rendered his decision in *Ex parte Dallioux*, adding as a logical corollary merely that the mark should not unduly emphasize the surname so as to amount to a “mere device or contrivance to evade the law.”

There has been no doubt as to the intended meaning of this Section on the part of such leading members of the profession as Ooms, Derenberg and Daphne Robert. See Appendices hereto 10a-13a.

Proposition No. 3.

A family name prefixed by two initials, all in type of equal size and prominence, cannot properly be considered “primarily merely a surname,” when the trade mark proprietor invariably presents the entire mark (family name and initials) in type of equal size and prominence in its own advertising and in its labels and when the entire name is invariably employed in customer communications and in trade paper references to the goods, and when names of the same type are commonly used to identify telephone subscribers.

Having seen that the purpose of Section 2(e)(3) is to exclude from registration only marks whose primary sig-

nificance is merely that of a surname, let us examine the J C HIGGINS trade mark to determine whether or not it comes within the purview of the Section.

The labels offered in evidence by Appellant show that Sears invariably presents the trade mark to the public on the goods as the unitary name J C HIGGINS, with the initials printed in letters of the same size and character as the surname, so that there is no emphasis whatever on the family name "HIGGINS."

The representative collection of advertising matter offered in evidence, comprising Appellant's catalogs over the years as well as its newspaper advertising, show the same type of presentation.

Furthermore, the public itself recognizes as Plaintiff's trade mark, not the surname HIGGINS alone, which the Patent Office blithely assumes with no proof whatever to be "the only significant part of the marks" but the entire trade mark J C HIGGINS, exactly as it has been presented to the public by the trade mark proprietor. This fact is conclusively established by the representative collection of customer communications and trade journal articles, also offered in evidence by Appellant.

The materiality of this evidence will be discussed herebelow, p. 34 *et seq.* At this point we will merely consider the factual question of whether or not the name J C HIGGINS is sufficiently distinctive and identifying to avoid being "primarily merely a surname", as these words were contemplated by Congress.

It is submitted that a visual inspection of the aforementioned material is sufficient to establish that the mark does not come within the purview of the Section or within the exception contemplated by Mr. Daniels in *Ex parte Dal-lioux*.

The pages offered in evidence from the Washington telephone book (Joint App. 28) confirm that an individual may be sufficiently identified by mere initials to avoid confusion with another subscriber having the same family name. A glance at this page, selected at random from the Washington telephone directory, or any page of any other directory, adequately establishes that subscribers in many instances consider themselves sufficiently identified by merely their initials.

If the Patent Office position were correct, that the surname is the "only significant part," no one would risk listing his name merely with initials to distinguish him from other members of a large clan, such as Douglas (Joint App. 15).

Proposition No. 4.

A family name prefixed by two initials, when it is the name of a living individual who consents to its use and registration, referring to it as "my name," cannot properly be considered "primarily merely a surname."

The stipulation of evidence (Plaintiff's Exhibit 2, Joint App. 23) and the letter forming a part of Appellant's application (Joint App. 36) show that at the time the application was filed John Higgins, then living, referred to the trade mark J C HIGGINS as "my name," stating under oath " * * * my name was adopted, with my permission."

Despite this showing, the Patent Office has arbitrarily taken the view that the name "J C HIGGINS" is nothing but a surname.

The trade mark clearly comes within the provision of Section 2 (c) of the 1946 Act, which provides:

"Sec. 2. No trade-mark by which the goods of the applicant may be distinguished from the goods of

others shall be refused registration on the principal register on account of its nature unless it * * *
(c) Consists of or comprises a name * * * identifying a particular living individual except by his written consent. * * *

The Patent Office seemingly assumes if the individual does not have a name fitting the ANDRE DALLIOUX pattern, it cannot be a personal name at all and then is merely a surname.

Such a view is inconsistent with the facts of life.

It is pointed out by Elsdon C. Smith, a member of the Chicago Bar, in "*The Story Of Our Names*" (Harper & Bros., 1950), that many people pass through life with strange and unusual names and it is not uncommon for one to be christened with mere initials in lieu of names. Thus, as stated by Smith, page 13:

"Some parents have given their children middle initials with the idea that they would fill them out when they wanted to. *Other parents have given only initials for Christian names*, and they have been used for that purpose throughout the lifetimes of their progeny. * * *

"In England there is a tendency to call men by the initials of their forenames plus the surname, as H. G. Wells and A. A. Milne. This custom is also found over here, particularly among business associates." (Emphasis added.)

Thus, we see that it is not at all unusual for individuals to be completely identified by initials alone throughout their lifetime, and many of the individuals listed in the telephone directory with mere initials may have no other names.

Therefore, the view of the Patent Office that J C HIGGINS is "merely a surname" is inconsistent not only

with the facts of this particular case but with common practice in the identification of individuals.

It is of no moment for the defendant here to argue that J C HIGGINS is unregistrable because it is not John Higgins' "full name." We have seen from the history of Sec. 2(e)(3), outlined above pp. 18-21 (Hearings, p. 18), that the drafters of the Section at one time considered using the expression "full name," but this terminology was *not* included in the Section as enacted. Hence, there is *no statutory basis* for excluding a name of the character of J C HIGGINS from registration on the ground that it is not a full name. Besides, ANDRE DALLIOUX was only part of the Applicant's name, Andre Julien Dallieux, and this was found registrable.

It is sufficient for our purposes that John Higgins acknowledged under oath that he permitted plaintiff to adopt "my name" in the form J C HIGGINS.

Proposition No. 5.

A composite trade mark should not be dissected into its elements in order to form a basis for refusing registration, but must be considered as a whole; when so considered, J C HIGGINS is not primarily merely a surname.

The above rule is so fundamental that citation of authorities is probably superfluous. In *Beckwith v. Commissioner of Patents*, 252 U. S. 538, 546, 64 L. ed. 705, 708, the Supreme Court said,

"The Commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety (*Johnson v. Brandau*, 32 App. D. C. 348), and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value."

Here the Supreme Court was considering an *ex parte* application to register a trade mark where the Patent Office had demanded deletion of a certain portion instead of disclaimer, as under the present practice.

Despite this basic and long accepted rule, the prior tribunals here have not only dissected the trade mark but completely *discarded* an essential portion thereof in ruling that only a fraction thereof “comprises the only significant part of the mark.”

Proposition No. 6.

The addition to initials, which alone are considered registrable by the Patent Office without recourse to Section 2(f), of a surname in type of the same size and prominence, does not result in an unregistrable mark.

Appellant offered in evidence a representative group of registrations of initials alone, some of these registrations being under the 1946 Act without recourse to Section 2(f). (Joint App. 23). They, too, were excluded.

It can not be said that these registrations represent errors on the part of the Patent Office because the law is well established that initials may constitute good technical trade marks. *Nims*, Fourth Edition, Sec. 209, pp. 598, *et seq.*

Yet the prior tribunals, by some strange circumlocution of reasoning, take the view that by adding to the initials J C, which would be registrable alone under the 1946 Act without reference to Section 2(f), the family name HIGGINS, then the registrability of the initials is destroyed and the complete mark thus produced becomes unregistrable. How this result is obtained, like the magician's trick, is not apparent, and it has never been explained.

Proposition No. 7.

Refusal to register the mark J C HIGGINS cannot be justified as protection of the public when a leading industry operating under the trade name HIGGINS, INC., and registrant of the trade mark "HIGGINS" for the same class of goods, sees "no conflict" and consents to Appellant's registration (Joint App. 39).

As seen from Appellant's file history, a rejection was entered based on a registration to Higgins Industries, Inc. (Joint App. 35) of the name HIGGINS for the same class of goods as those for which Appellant sought registration. This ground of rejection was dropped pursuant to the filing of a letter (Joint App. 39) from Higgins, Inc., over the signature of its President, Andrew J. Higgins, consenting to Appellant's registration of J C HIGGINS because they could "foresee no conflict between your trade-mark and that of our HIGGINS." See App. 2a hereto.

The only possible basis on which the Patent Office could justify its refusal to register Appellant's mark would be the exercise of its function of protecting the public, including competitive industry, from the possibility of confusion. Yet, here we find that the only known source of possible confusion acquiesced in Appellant's registration because it could "foresee no conflict" between the two trade marks. This acquiescence constitutes a direct contradiction of the Patent Office view that HIGGINS is "the only significant part" of the mark, from an element of the public which should be most sensitive to any likelihood of confusion.

Proposition No. 8.

The Patent Office has no right to require a trade mark applicant to accept a registration under Section 2(f) of the 1946 Act, which provides for registration of an otherwise unregistrable mark upon proof that it has acquired "distinctiveness," when the mark is eligible for registration without recourse to that section. Until Section 2(f) of the new law is thoroughly adjudicated, the legal profession regard it as affording protection of only secondary value.

Appellant's mark would be registered under Section 2(f) of the 1946 Act upon the filing of proof that the mark has acquired "distinctiveness", which in this case can readily be done under current Patent Office practice.

But no reason is seen why Appellant should be required to accept this "just as good" bill of goods offered by the Patent Office. In the view of Appellant's counsel, a Section 2(f) registration is *not* "just as good" as a registration without recourse to Section 2(f) for a number of reasons which need not be discussed at length here. Suffice it to say that, in view of the short time in which the 1946 Act has been in effect and the dearth of appellate decisions under that law, the value of a Section 2(f) registration is still uncertain, and until such registrations have been adjudicated by the highest tribunals it is the general feeling in the profession that such registrations may be of secondary value. See *The Conde Nast Publications, Inc. v. Vogue School*, 94 U. S. P. Q. 101, 105.

Proposition No. 9.

A trial court in an equity suit under R.S. 4915 to direct the grant of a trade mark registration, after the Patent Office has ruled that a certain portion thereof is "the only significant part," should not exclude as "immaterial" substantially all of the Plaintiff's proofs offered to establish that the mark is presented by the Plaintiff to the trade and is employed by the trade itself in a manner clearly disproving that construction, i.e. evidence on the point which the Patent Office had made the very crux of the case.

In the final action of the Examiner dated February 1, 1950 (Joint App. 47), said official presented the question which was the major point for determination by the Trial Court, in the following language:

"A full personal name should not be refused registration on the Principal Register under the 1946 Act. Applying this ruling, set forth and very clearly delimited as to scope in the Dallioux decision, to the present application, the question is presented: Is the designation "J C HIGGINS" the 'entire name of an individual' or is it 'a mere device or contrivance to evade the law and secure the registration of non-registrable words'?"

In this the Examiner was raising a straw man to knock down, for we have seen that there is no statutory basis for his "full name" requirement. See *supra*, pp. 18-21, 25; Hearings, p. 18 (Appendix 4a hereto).

The Examiner stated as his conclusion that the surname HIGGINS "comprises 'the only significant part of the mark'".

Appellant chose to proceed under Section 4915 R.S. in preference to appealing to the Court of Customs and Patent Appeals for the reason that Section 4915 offered

Appellant an opportunity for a trial *de novo*, as Appellant wished to present to the Court evidence bearing on the question of fact which the Examiner had deemed the very crux of the case.

Appellant believed such evidence would controvert the Examiner's conclusion.

This evidence, of which Appellant made profert in accordance with Rule 43(c) F.R.C.P., consisted of a collection of labels showing the manner in which Appellant used the trade mark on its goods in commerce; a representative collection of Appellant's catalog and newspaper advertising likewise showing how it presented the trade mark to the public; a collection consisting of all communications over a certain period which made reference by name to J C HIGGINS merchandise rather than catalog number (Joint App. 17-20); also, trade journal references to Appellant's J C HIGGINS merchandise which were produced outside Appellant's control as well as certain trade journal advertising sponsored by Appellant.

In addition to the above, Appellant also offered in evidence a sampling of trade mark registrations of initials alone and a page from the Washington, D.C., telephone book to show the common practice of individuals being identified merely by initials.

All of this material was excluded as 'immaterial' over Plaintiffs' exception. (Joint App. 27.)

It has been stated by the authorities that a word has not acquired trade mark significance unless and until it acquires *through use* a secondary or trade mark meaning, for the association, not the first use, is the basis of trade mark rights. *Hanover Star Milling Co. v. Allen & Wheeler*, 208 Fed. 513; affirmed 240 U. S. 403, 60 L. ed. 713, 36 S. Ct. 357.

The Second Circuit Court of Appeals has carried this philosophy to the point where it held trade mark rights to have been destroyed because the mark had lost any trade mark significance *in the public mind* as to origin of the goods. *DuPont Cellophane Co. v. Waxed Products Co.*, 85 F. (2) 75, 30 U. S. P. Q. 332 (CCA 2, 1936).

In view of this principle of law, it is submitted that the evidence offered by Appellant is highly material to the question which the Patent Office had made the very crux of the controversy.

Rule 43(a), F.R.C.P., reads as follows:

“EVIDENCE. FORM AND ADMISSIBILITY. In all trials the testimony of witnesses shall be taken orally in open court, unless otherwise provided by these rules. All evidence shall be admitted which is admissible under the statutes of the United States, or under the rules of evidence heretofore applied in the courts of the United States on the hearing of suits in equity, or under the rules of evidence applied in the courts of general jurisdiction of the state in which the United States court is held. *In any case, the statute or rule which favors the reception of the evidence governs* and the evidence shall be presented according to the most convenient method prescribed in any of the statutes or rules to which reference is herein made. The competency of a witness to testify shall be determined in like manner.” (Emphasis added.)

This rule represents an attempt to clarify and liberalize the rules governing the admissibility of evidence in the Federal courts. (Note, 46 Col.L.R. 267, 1946; *U.S. v. Aluminum Co. of Am.*, 1 FRS 43a, 3, Case 1 (SD, NY).

Rule 43(a) is a rule of admission, not exclusion, and if the evidence is admissible under any of the tests set out in the rule, it may be admitted. *Wright v. Wilson*, 154 F(2) 616 (CCA 3, 1946).

As stated in *Pierkowskie v. N. Y. Life*, 147 F(2) 928, 933 (CCA 3, 1945):

“The Federal Rules of Civil Procedure are to be construed liberally. Rule 43(a) is designed to favor ‘the reception of the evidence’; that is to say, *all of the evidence* which properly may be introduced in respect to the point in controversy.” (Emphasis added.)

Where there is doubt as to admissibility of evidence, *any doubt should be resolved in favor of admission*, in the absence of a statutory restriction. *Cyc. Fed. Proc.*, Vol. 8, p. 351; *Neff v. Penn. R. Co.*, 11 F.R.S. 43a.23, Case 1 (D.C. Pa., 1948); *Mourikas v. Vardianos*, 169 F. (2) 53 (C.C.A. 4, 1948).

Where evidence is in the record, the Appellate Court may consider it, if legitimate, even though excluded by the lower court. *F. H. McGraw & Co., Inc. v. Milcor Steel Co.*, 149 F. 2d 301 (C.C.A. 2, 1945).

Proposition No. 10.

In case of doubt as to the correct interpretation of the 1946 Act, such doubt should be resolved in favor of the applicant for registration, because, in the event of an improvident decision in the applicant's favor, all persons are fully protected under the 1946 Act by their right to oppose the grant of the registration or, if by inadvertence no opposition is filed, they may file a petition to cancel the registration.

The ultimate interests of both the applicant and the public are involved in the allowance or rejection of an application for registration of a mark under the Act of 1946. A mistake in judgment resulting in a refusal to register always injures the applicant, and may also damage the public, because of the greater probability of fraud and deception. On the other hand, a mistake in judgment

due to resolving the doubt in favor of the applicant involves no substantial injury to the public, because Sections 13 and 14 of the 1946 Act provide for the filing of an opposition or a petition to cancel by any one claiming to be injured by a prospective or existing registration.

In these respects the examination of trade marks involves considerations quite different from those in patent cases. In patent cases there are no provisions for opposition or cancellation. Hence, an over liberal granting of patents might have serious effect upon the rights of the public, whereas in trade mark cases the public has ample protection against a too liberal Patent Office policy. Yet, even in patent applications doubts are resolved in favor of the applicant.

Proposition No. 11.

Findings of a trial court should be reversed or modified where clear error appears.

It has been said that the findings of a trial court should not be disturbed in the absence of clear error (*Graver v. Linde*, 339 U.S. 605). The Supreme Court has with equal emphasis ruled conversely, *i.e.*, that where clear error is found, even, with concurring opinions of two lower tribunals, such findings will be set aside (*A. & P. v. Super Market*, 87 U.S.P.Q. 303; *U. S. v. Gypsum Co.*, 333 U. S. 364, 92 L. ed. 746).

In the instant case, with regard to "Findings of Fact" 6—9, the Trial Court was clearly in error in arriving at these findings because he had already excluded substantially all of Plaintiff-Appellant's offered evidence, and none had been offered by Defendant. Hence, these "Findings of Fact" were mere conclusions of opinion on the part of the trial judge, unsupported by any verified evidence whatever.

Proposition No. 12.

Where a statutory grant is expressed in general terms, any exception or proviso requires the strictest interpretation, and any doubt should be resolved in favor of one who qualifies under the general grant.

Section 2 of the 1946 Act says that:

“No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature, unless it * * * consists of a mark which * * * is primarily merely a surname * * *”

It is seen that this exception or proviso follows the general enactment to the effect that “no mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register * * *,” etc. The law is clear that under these circumstances, *i.e.*, where a proviso seeks to except something from the general language of a remedial statute, the proviso should be strictly construed and that the exceptions must be clearly established. See *U. S. v. Dickson*, 40 U. S. 141, 165 (Story, J.):

“* * * we are led to the general rule of law which has always prevailed, and become consecrated almost as a maxim in the interpretation of statutes, that where the enacting clause is general in its language and objects, and a proviso is afterwards introduced, that proviso is construed strictly, and takes no case out of the enacting clause which does not fall fairly within its terms. In short, a proviso carves special exceptions only out of the enacting clause; and *those who set up any such exception, must establish it as being within the words as well as within the reasons thereof.*” (Emphasis added.)

We know of no decision which has overruled *U. S. v. Dickson*, 40 U. S. 141, *supra*. The same principle is affirmed in *U. S. v. Morrow*, 266 U. S. 531.

In the instant case, the Patent Office admits that Appellant's goods "may be distinguished" by the mark J C HIGGINS. As the Solicitor said at the trial, "It is not in issue here." (Joint App. 16.)

In *Ryan v. Carter*, 93 U. S. 78, the Supreme Court lays down the rule that, in construing a proviso, that construction should be adopted which withdraws the least possible number of cases from the operation of the statute.

Applying these familiar principles, it would seem that, unless beyond all reasonable doubt the mark of Appellant is shown to be "primarily merely a surname", it is the duty of the Patent Office to register it. Should there be any lingering doubts, those doubts should be resolved in favor of appellant. See *Ex parte Kullman, Salz & Co.*, 8 T. M. Rep. 318; *National Food Broker's Association*, 17 T. M. Rep. 409.

Applying the law to the facts of the instant case, it clearly appears that the mark J C HIGGINS, invariably presented as a unit with the initials J C in type of the same character and prominence as the family name HIGGINS, and so recognized by the public and the trade, as clearly shown in the evidence offered to the Trial Court, could not reasonably be construed as "primarily merely a surname" and thus coming within the exception or proviso of Section 2.

We submit, therefore, that the Trial Court erred in its "Findings of Fact" Nos. 6 to 9, inclusive.

CONCLUSION.

1. The Patent Office officials concede that Appellant's mark J C HIGGINS is a proper trade mark, registrable under Section 2 (f), although Appellant has declined to accept such "just as good" protection.

2. The meaning of Section 2(e)(3) is clear on its face as intending to exclude from registration only names whose *primary* significance is "merely a surname"; there was no intention of reenacting the prohibition of the 1905 Act against registration of full *personal names* for, if such had been the intent, Congress would not have employed different language. If there should be any question as to the Congressional intent, such intent is clear from the Transcript of Hearings appended hereto. Said Transcript may properly be considered by this court as an external aid to construction, if such is necessary. *In re Martin*, 661 O.G. 327, 328; 93 U.S.P.Q. 173, 174 (C.C.P.A., 1952).

"A strict reading of Section 2(e)(3) would indicate that Congress did not expressly exclude the name of an individual, *provided the dominant characteristic of the mark was not the surname.*" *Kimberly-Clark Corp. v. Marzall*, 88 U.S.P.Q. 277, 280, Kirkland, J., emphasis added. Considering J C HIGGINS as a whole, HIGGINS is *not* the dominant characteristic.

3. The evidence offered by Plaintiff should have been accepted, and, if accepted, would have been found to controvert the point which the Patent Office had made the crucial point of the case, *i.e.*, it would have shown that the surname HIGGINS was *not* the "only significant part" of the trade mark.

The District Court should, accordingly, be reversed and it should be directed to award to Plaintiff-Appellant the relief prayed for in the Complaint.

Respectfully submitted,

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*Attorneys for Plaintiff-
Appellant.*

September 5, 1952.

APPENDICES TO APPELLANT'S BRIEF.

	APP. No.
(1) Trade-mark Registration No. 415,944 to Higgins Industries, Inc., withdrawn as basis for refusing Appellant's registration after consent given	2a
(2) Report of Hearings before the Committee on Patents, Subcommittee on Trade-Marks, House of Representatives, 76th Congress, 1st Session, on H.R. 4744, March 28, 29, 30, 1939, pp. 18-19, 39-41	3a-8a
(3) Derenberg, <i>Threshold of the Lanham Trade Mark Act</i> , 37 T.-M. Rep. 302 (May, 1947)	9a
(4) Ooms, <i>How the Lanham Act Affects Trade-Marks</i> , 37 T.-M. Rep. 383-384	10a-11a
(5) Daphne Robert, <i>The New Trade-Mark Manual</i> , p. 61	12a
(6) Dictionary definition of <i>surname</i> , and the pertinent sections of the 1905 Act and 1946 Act	13a

Registered Aug. 21, 1945

Trade-Mark 415,944

Republished, under the Act of 1946, Dec. 15, 1949, by
Higgins Industries, Inc., New Orleans, La.

UNITED STATES PATENT OFFICE

Higgins Industries, Inc., New Orleans, La.

Act of February 20, 1905

Application February 6, 1945, Serial No. 479,478



STATEMENT

The Commissioner of Patents:

Higgins Industries, Inc., a corporation duly organized and existing under the laws of the State of Louisiana, located and doing business at City Avenue, in the city of New Orleans, Parish of Orleans, and State of Louisiana, has adopted and used the trade-mark shown in the accompanying drawing, for POWER GUN TURRETS, MACHINE GUN TURRETS, TORPEDOES, AND HIGITE, AN EXPLOSIVE, in Class of Explosives, firearms, equipments, and projectiles, and presents herewith five specimens showing the trade-mark as actually used by applicant on the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended. The trade-mark has been continuously used and applied to said goods in applicant's business as to the word "Higgins" since June 1, 1943. The facsimile signature was first used January 20, 1943. The trade-mark is applied or af-

fixed to the goods, or to the packages containing the same, by means of a label or wrapper bearing the mark, or by printing or impressing the mark thereon, and in divers other ways. The mark is a facsimile signature of A. J. Higgins, President of applicant corporation.

The undersigned hereby appoints the firm of Mason, Fenwick & Lawrence, of 726 Woodward Bldg., 15th and H Streets N. W., Washington 5, D. C. (Edward G. Fenwick and Charles R. Fenwick constituting said firm), registered attorneys, No. 393, its attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign its name to the drawing, and to transact all business in the United States Patent Office connected therewith.

HIGGINS INDUSTRIES, INC.,
By A. J. HIGGINS,
President.

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TRADE - MARKS

HEARINGS

BEFORE THE

COMMITTEE ON PATENTS

SUBCOMMITTEE ON TRADE-MARKS

HOUSE OF REPRESENTATIVES

SEVENTY-SIXTH CONGRESS

FIRST SESSION

ON

H. R. 4744

MARCH 28, 29, 30, 1939



UNITED STATES
GOVERNMENT PRINTING OFFICE
WASHINGTON : 1939

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Mr. LANHAM. There are no further suggestions, I take it, with reference to section 1. If not, we will take up section 2. [Reading:]

Marks Registrable on the Principal Register.

SEC. 2. No mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration as a trade-mark on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which tends to disparage persons, living or dead, institutions, beliefs, or national symbols, or to bring them into contempt;

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof;

(c) Consists of or comprises the name, portrait, or signature of a living individual unless by his written consent;

(d) Consists of or comprises a mark which so resembles a trade-mark previously registered by another under the act of February 20, 1905, as amended, or upon the Principal Register provided by this act, as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers;

(e) Consists of a mark which, when applied to the goods of the applicant, has merely a descriptive or geographical, and no other, meaning, except as such marks may be registrable under section 4, or is merely the name of an individual and has no other meaning;

(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of any mark used by the applicant as a trade-mark which has become distinctive of the applicant's goods in commerce.

Mr. THOMSON. In subsection (c) before the word "name" insert the word "full." Subsection (c) refers to the name of a living individual. Subsection (e) refers to the name of an individual. I think under subsection (c) where I refer to the full name that the Patent Office will not refuse to register "Thomson for Shoes" because they have not secured my consent. The same language is used showing the name of an individual in subsection (e), and there should be some distinction made.

Mr. LANHAM. What suggestion would you make with reference to its modification?

Mr. THOMSON. I suggest the insertion of the word "full" before the word "name," making it read "full name."

Mr. LANHAM. What is your reaction to that, Mr. Rogers?

Mr. ROGERS. I do not see any objection to that at all, Mr. Chairman.

Mr. LANHAM. You have no objection to that?

Mr. ROGERS. Personally I think it is a good idea, unless there is objection.

Mr. LANHAM. Mr. Robertson.

STATEMENT OF THOMAS E. ROBERTSON, WASHINGTON, D. C.

Mr. ROBERTSON. Thomas E. Robertson, of Washington, D. C. It seems to me, Mr. Chairman, that we have left out something from the present statute which should be included in it. I remember that Senator Glass had a statute passed which provided for the amending of the act of 1920 so as to provide, for example, that a picture of an ex-President of the United States, even though dead, could not be used without the consent of his widow. Now, here this subsection (c) says: "Consists of or comprises the name, portrait, or signature of a living individual unless by his written consent." I think that should

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be amended so as to prevent the use of any person's name, portrait, or signature, living or dead.

Mr. LANHAM. There would have to be a modification with reference to his consent if he were dead. Somebody else would have to give that.

Mr. ROBERTSON. I think we should prohibit it entirely.

Mr. LANHAM. Prohibit it entirely?

Mr. ROBERTSON. Yes. Why should the Congress of the United States, for example, permit Benjamin Harrison's name, and I am picking out an ex-President so far back so that his widow is dead, why should the Congress of the United States permit Benjamin Harrison's name to be used as a trade-mark on any article, device, or merchandise, even though dead?

Mr. MARONEY. In other words, we would not want to have Abraham Lincoln gin.

Mr. ROBERTSON. No, sir; we would not.

Mr. FENNING. Or George Washington coffee.

Mr. ROGERS. There was a good deal of discussion last year about that very thing, and considerable difficulties seem to arise in connection with it which ever way we jump. I quite agree that Abraham Lincoln gin ought not to be used, but I would not say the use of G. Washington on coffee should not be permissible. We attempted to take care of it in subsection (a) of section 2: "Consists of or comprises immoral, deceptive, or scandalous matter; or matter which tends to disparage persons, living or dead, institutions, beliefs, or national symbols, or to bring them into contempt." That would take care of abuses, but it would not prevent the perfectly legitimate use of names.

I would like to make a suggestion, and that is that it seems to me the language in subsection (c) is not altogether happy. There is a practical difficulty that is encountered in the Patent Office, and one which has been encountered in every Patent Office in the world, as far as I know, as to what is a geographical name. The present statute prevents the registration of geographical names as trade-marks. Some people take the position that any name is found somewhere in the the Postal Guide, and hence is not a registerable name. For instance, Pink, Red, Fish, Green, Greenfield, Lily Pons, and so forth, are all found in the Postal Guide. They are the names of individuals or persons and shall not be registered. There is somewhere on the earth's surface some person who has any name that you can possibly think of. The result of that is that if literally interpreted that provision in the present act prohibits the registration of nearly any word that anybody can think of. I would suggest that subsection (c) be amended to read this way, and I think it carries out the same idea and, perhaps, makes it a little clearer:

(1) which, when applied to the goods of the applicant, is merely descriptive of them.

(2) when applied to the goods of the applicant, is primarily geographical and descriptive of them, except as such marks may be registrable under section 4 hereof.

(3) is merely and primarily the name of a particular person other than the applicant.

That is to get away from this idea of a surname. Any name can be a surname, such as Cotton, King, Jack, Knife, Ink, and the like, but it is not the name of any particular person.

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TRADE-MARKS

WEDNESDAY, MARCH 29, 1939

HOUSE OF REPRESENTATIVES,
SUBCOMMITTEE ON TRADE-MARKS OF THE
COMMITTEE ON PATENTS,
Washington, D. C.

The subcommittee met, at 10 a. m., pursuant to adjournment, for further consideration of H. R. 4744, Hon. Fritz G. Lanham presiding.

Mr. LANHAM. The committee will come to order. I have a letter here addressed to the chairman of the Committee on Patents, from the National Association of Manufacturers, 14 West Forty-ninth Street, New York, N. Y., under date of March 28, which will be placed in the record with the other statements.

When we recessed on yesterday we had under consideration, as I recall it, subsection (f) of section 2. Before taking that up, you gentlemen were working on phraseology on a part of the first section, and I wonder if that is ready for inclusion in the record at this point?

Mr. ROGERS. Yes, sir; it is, and if I may read it I will do so.

Mr. LANHAM. Yes, Mr. Rogers; please.

Mr. ROGERS. In section 1, page 2, line 4, subsection (3) (b), cancel "the sum of \$15" and substitute in lieu thereof the words "filing fee."

In subsection (3) (d), in line 10, after the word "office" insert the words "the name and address of."

Also in the same section, line 14, add a new sentence reading as follows:

If the person so designated cannot be found at the address given in the designation, such notice or process may be served upon the Commissioner.

Mr. LANHAM. That is in section 2?

Mr. ROGERS. No, that is in section 1.

Then, in section 2, page 3, line 6, cancel, "under the act of February 20, 1905, as amended, or upon the principal register provided by this Act,". Also cancel lines 11 to 15 in subsection (e), and substitute in lieu thereof:

Consists of a mark which (1) when applied to the goods of the applicant is merely descriptive of them. (2) When applied to the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registered under section 4 hereof. (3) Is primarily a surname.

Then, add to subsection (f), in line 20, a new sentence as follows:

Substantially exclusive use as a trade-mark by the applicant in commerce for 2 years prior to application may be accepted by the Commissioner as prima facie evidence of distinctiveness.

Mr. LANHAM. That latter provision is simply permissive, and it is not mandatory?

Mr. ROGERS. Exactly, and as I understand from Mr. Frazer it meets the administrative difficulty that he felt existed.

Mr. FENNING. Should we speak to these proposed amendments as we go along?

Mr. LANHAM. First of all I want to thank you gentlemen for the trouble to which you have gone in preparing these amendments. Did you have an observation to make, Mr. Fenning?

Mr. FENNING. Yes; I have one with respect to amendment (e). As I remember Mr. Rogers said this is primarily the name of a particular person other than the applicant. Now, I apprehend that that will mean the complete name of a man. In other words, there is no inhibition here, apparently, against registering the name "Wilson" but there is an inhibition against the registration of the name, "John W. Wilson?"

Mr. LANHAM. Did we not put an amendment in subsection (c) calling for the whole name?

Mr. FENNING. That is right, but here we are calling for the full name of the person also. So, there is no objection against registering the surname. It seems to me that we ought to have the "surname of a particular party" rather than the name of a particular party in subsection (e).

Mr. ROGERS. No; I do not think so at all. The difficulty about that is that almost every word you can think of is somebody's surname, somewhere, and there has been a practice in the office of the Commissioner of Patents, which was born a number of years ago that any mark for which registration was applied, which was borne by some person, somewhere as a name such as Cotton, King, or what-not, they would refuse registration on the ground that they were merely the names of individuals. It is perfectly all right to refuse registration where the name is a name of a particular individual, but where it falls into the general category that there might be a surname somewhere of that kind, that somebody somewhere may bear that name, it merely limits the field of choice.

Mr. FENNING. Mr. Rogers does not see the point I am making, and he does not mention surname in his section.

Mr. ROGERS. The present act prohibits the registration of the name of an individual, and that has been construed to mean a surname. In fact, in the Court of Customs and Patent Appeals the name "Wix" was found to be the name of somebody somewhere. It was found in the directory, and, therefore, it was not registrable. It was the name of an individual. I contended that Wix was not the name of an individual, but the name of a clan, but the court said that was a surname of an individual, and, therefore, it cannot be registered as a trade-mark. So, I changed that to say primarily the name of a particular person.

Mr. FENNING. Then, if that is true, any member of a clan is a particular person who bears that name, so I do not think you have accomplished anything by adding that, except to make it possible to register a surname. We do not want to register the word "Johnson" or "Smith."

Mr. ROGERS. No; but you do not object to registering the name Jack, King, Queen, or Tan.

Mr. FENNING. When you say the name of a particular individual that necessarily means that particular individual's name.

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Mr. ROGERS. I cannot see how you come to that conclusion.

Mr. FENNING. We must have a surname in there if you are going to specify a particular individual, because when you say a particular individual you mean not merely his surname, but all of his name.

Mr. ROGERS. I do not think it should be surname, because the minute you get into that, you get into the fact that every name you can think of is somebody's surname.

Mr. FENNING. You have not accomplished anything at all by saying the name of a particular individual.

Mr. LANHAM. From the standpoint of administration, Mr. Frazer, what are your observations with reference to this matter?

Mr. FRAZER. It seems to me it would be rather difficult to determine in the Patent Office whether a name is a surname of a particular individual other than the name of the applicant. For instance, my name is Frazer, and I am quite sure that I am a particular individual, and I am sure that Mr. Rogers' phraseology hardly meets the situation that he is trying to remedy. In the absence of this discussion, if that section were before me for interpretation, I would certainly say that it prevented the registration of the name "Johnson" or "Jones," because it is common knowledge that the names Johnson and Jones are the names of a good many particular individuals.

Mr. ROGERS. Well, if it will meet the objection, and whatever you do, you are going to meet something unfavorable, would this meet the situation: "Is merely and primarily a surname"?

Mr. CARTER. How about a name which identifies the particular individual?

Mr. FENNING. Or, how about a given name?

Mr. FRAZER. You say merely and primarily a surname?

Mr. ROGERS. Yes; merely and primarily a surname.

Mr. FRAZER. Then I would suggest that you leave out the word "merely."

Mr. ROGERS. Well, Johnson is primarily a surname, and Cotton is not.

Mr. FRAZER. Yes; but when you say "merely" a surname, you would prohibit the registration of such names as Cotton; and King, as you suggested, Mr. Rogers.

Mr. ROGERS. Suppose we make it read: "Is primarily a surname"?

Mr. FRAZER. Yes; I think insofar as the Patent Office is concerned that that would simplify the administration of it.

Mr. ROGERS. Does that meet your point?

Mr. FENNING. Yes; but we will still have the question coming up to consider: Are we going to allow William to be registered, or are we going to allow John to be registered?

Mr. ROGERS. Why not?

Mr. FRAZER. We do under the present law.

Mr. FENNING. Then let us know if we are going to continue it.

Mr. LANHAM. Are there any further observations or suggestions that anyone desires to make with reference to section 2?

Mr. WHITMAN. It seems to me we ought to include in section 2 (d) reference to use of a mark that has been used, because I believe that it is very important that a man who has actually used a mark before a person applies to register his mark should be given an opportunity to oppose or prevent the registration of that mark, since he has acquired rights to it by his prior use, which should be respected. They

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on the main register even though they may have found ample protection by the equity courts against infringement or unfair competition. The rigid disqualification of surnames, unless they are so distinctively displayed as to become the minor element of the entire trade-mark, has proven particularly detrimental and inconvenient to industries such as the cosmetic industry in which by far the greater number of famous trade-marks either constitute or are derived from the names of their owners. It seems that from time immemorial manufacturers have taken justifiable pride in using their own names as designation of their merchandise and they are usually not easily persuaded by their counsel to forego use of their own name as a mark in favor of an entirely arbitrary new device which may be easier registrable under the law. Take such famous names as, for instance, "Coty," "Guerlain," "Chanel," "Elizabeth Arden," "Dorothy Gray," and innumerable others. None of these names as such can be registered as trade-marks under the present Act of 1905 unless they have been in 10 years exclusive use prior to 1905. But not only that: The Patent Office in considering registrability has until now applied the so-called "telephone book test." Whenever a mark or name which might possibly be the name of a living individual is sought to be registered, the Trade-Mark Division will pick up a number of telephone directories and if such name appears in one of them, the mark will be refused. In a rather recent case, an applicant pointed out in vain that the name did not appear in any of the New York telephone directories containing several million names. Since it appeared in the Washington book, it was refused registration. Under the new law this will no longer be true. In order to be rejected, the name must be "primarily merely a surname." Moreover, if it can be shown that a surname has acquired distinctiveness over the course of years, it will now be registrable on the principal register even though it may be a common surname as applied to other merchandise. As you may have seen in a very recent issue of *Life Magazine*, even such a common name as "Smith Brothers" may acquire distinctiveness as applied to cough drops over a course of a 100-year period.

The new Act also gives much more latitude in using a name which may have some remote geographical significance. Not only may such name become a valid trade-mark after having acquired distinctiveness but the new law excludes geographical names from the register only if they are *primarily* merely geographical when applied to the goods of the applicant. Thus, the Patent Office should no longer refuse registration of the word "Kem" for playing cards on the ground that "Kem" is the name of a small river in Siberia. Moreover, it can be argued under the new law that a comparatively well-known geographical term may not be considered merely geographical if applied to particular merchandise. Even a designation such as "Philadelphia Cheese" may acquire distinctiveness as a trade-mark. In England, on the other hand, the mark "Liverpool" for cables was rejected despite a recognized secondary meaning on the ground that some geographical words are so predominantly geographical that under no circumstances could they ever acquire a true trade-mark significance.

The provisions of the new law with regard to descriptive terms are also somewhat more flexible although the new law still excludes "merely descriptive" marks without regard to whether they are primarily so. But they must be merely descrip-

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PART I

HOW THE LANHAM ACT AFFECTS TRADE-MARKS*

Hon. Casper W. Ooms

It may be somewhat bold for anyone to venture upon a discussion of the Trade-Mark Act of 1946, popularly known as the Lanham Act, as probably more has been written about the law of trade-marks since and because of the passage of this Act a year ago than has been written on that subject since the beginning of the law of trade-marks. I shall, therefore, today attempt no more than a discussion of the salient features of the Lanham Act as they appear to me.

What I shall attempt is: First, a discussion of the expansion of registrability under the Act; second, the innovation of incontestability provided for by the Act; third, the improved remedies created by the Act; and fourth, the incidental benefits of this legislation. Fifth, and finally, I shall discuss briefly the alarms and fears that the Act has created.

1. Expansion of Registrability Under the Act

There can be no question that the Lanham Act, expressing the experience of business with many of the limitations of our previous trade-mark legislation has greatly expanded the opportunities for registering trade-marks. While the statute contains many of the positive prohibitions of the old law against the registration of undesirable marks such as those comprising immoral or scandalous matter, and the flag or coat-of-arms or other insignia of the United States, a state or municipality or any foreign nation, the Act adds a prohibition against those which "disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute," and expressly states that "no trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature" unless it falls within the specified prohibitions. This is the direction to the Patent Office, and I think to the courts, that technicalities unduly hampering registration are to be avoided and that each mark is to be examined to determine its capacity to serve as a trade-mark without creating the possibility of confusion with a mark of another.

The Act clearly carries out this suggestion in eliminating much of the technical language that created difficulty where registration was sought of a mark that had some resemblance to the mark of another, and was therefore forbidden registration. The Lanham Act now compels such contests to be determined upon the answer to the question whether the proposed mark so resembles the mark previously registered or used "as to be likely, when applied to the goods of the applicant, to cause confusion or mistake or to deceive purchasers."

Similarly, the Act expands the opportunities for registration of marks which

* Remarks by Hon. Casper W. Ooms, United States Commissioner of Patents, delivered at a meeting of the Commerce and Industry Association of New York on July 9, 1947.

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would previously have been rejected as geographical. It requires that the mark to be denied registration must be "primarily geographically descriptive or deceptively misdescriptive."

As an example of this problem I recall the decision made in the Patent Office some years ago denying registration of the mark "Kem" for a plastic playing card. (The illustrations I employ I choose merely for their simplicity and not because they present any existing problems. Like the fiction writers, I deny any similarity to living trade-marks except for pure coincidence.) Now, this mark "Kem," which was a very happily chosen trade-mark, was rejected because some geographies said this name "Kem" was the name of a river in Russia. I am confident that under the new Act that ground of rejection no longer exists.

Another ground of rejection that has been removed from the trade-mark law is the ground that the mark is merely a surname or the name of a firm or corporation. Now the mark "Kem" also happens to be the name of a United States Senator. Under the old law we would have been compelled to reject an application for registration of that mark on that additional ground. Our practice in the Patent Office was to consult fifteen telephone directories of the leading cities. It might very well be that a name, like my own, would appear only in another directory than one of the fifteen selected, and its registrability would thus depend upon an accident of telephone book selection never contemplated by the law, but made necessary by the practical problems of administration.

Also under the old law, if there had been a corporation manufacturing steam shovels known as Kem, Incorporated, we would have had to reject the proposed mark "Kem" for playing cards on that ground.

The elimination of the mere existence of a surname or the name of a corporation as grounds for rejection is an extremely fortunate one. For example, if someone presented the mark "Kodak" for registration under the old law, we would have merely looked into the Washington telephone directory and found the name of Mrs. Helen Kodak and that would have presented an insuperable ground of rejection. Today that ground of rejection no longer exists unless the name is primarily merely a surname.

Similarly, there is a trade-mark for a metal polish "Noxon," which by all tests of trade-mark law and merchandising practice is a well-chosen mark, as it can be read and printed with equal facility upright or upside down, is purely arbitrary, has no confusing other meaning, is easily written and remembered, presents no problem of pronunciation, etc. If that mark were presented under the old law we would look into the Washington telephone directory and find that Mrs. William Noxon was there registered and would have had to reject the mark. Under the present law that is no longer true.

The Lanham Act goes farther. It provides that marks made unregistrable by specific terms of some provisions can be registered when these marks have become "distinctive of the applicant's goods in commerce." The law administered by the courts, as distinguished from the old trade-mark act, long recognized this principle of "secondary meaning, but there was no way of registering such marks in the United States Patent Office (except for ten years' exclusive use prior to 1905), where those searching trade-marks to avoid confusing use of similar marks might

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Under the Act of 1905 a mark which was "merely a geographical name or term" was unregistrable. The strict construction of the provision resulted in denial of registration of marks found in atlases, postal guides or geographical dictionaries, but which were primarily identification marks which distinguished the applicant's goods. Under the new Act, the mark sought to be registered must be "primarily geographical," that is, must have no meaning to the public other than as the designation of a geographical location, to be rejected *ex parte*. If it distinguishes the goods or services of the applicant from others, it may be registered, even though it is also a geographical name.

Individual names and surnames were unregistrable under the Act of 1905, unless they were written, printed, impressed or woven in some particular or distinctive manner or in association with a portrait of the individual. This provision, too, was so strictly construed as to prevent registration, as marks, names which were so rare that they had no significance as a surname and were distinctive marks as applied to the applicant's goods.⁴⁴ It has been said that if the city directories of twenty of our largest cities were searched, more than half of the registered marks would be listed as surnames. The only surnames which are prohibited registration under the new Act are those which are "primarily merely a surname" and have no other significance. This is as it should be. It is extremely doubtful whether the public thinks that "Du Pont," "Ford," and "Chevrolet," are family names.

B. Names

"Trade names" and "commercial names" include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.⁴⁵

⁴⁴ American Tobacco Co. v. Wix, 16 USPQ 181, 62 F.2d 835.

⁴⁵ Section 45.

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sur'name, n. (From Fr. surnom, surname.) An additional name or appellation added to the baptismal or Christian name, to render it more definite or distinct, afterward often becoming a family name; hence, a family name.

(Webster's Universal Unabridged Dictionary,
1937 Edition)

- - - -

Act of February 20, 1905 (as amended)

Sec. 5. ...Provided, That no mark which consists merely in the name of an individual .. not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual ... shall be registered under the terms of this Act...

- - - -

Trade Mark Act of 1946

Sec. 2. Trade marks registrable on the Principal Register.

No trade mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the Principal Register on account of its nature unless it --

(c) Consists of or comprises a name ... identifying a particular living individual except by his written consent ...

(e) Consists of a mark which... (3) is primarily merely a surname.

(Emphasis added)

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REPLY BRIEF FOR PLAINTIFF-APPELLANT.

IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA

No. 11,454

SEARS, ROEBUCK AND CO.,

Appellant,

vs.

ROBERT C. WATSON

JOHN A. MARZALL, COMMISSIONER OF PATENTS,

Appellee.

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA

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January 27, 1953.

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REPLY BRIEF FOR PLAINTIFF-APPELLANT.

**Commissioner's Brief Discloses Fundamental Error
in Patent Office Philosophy.**

The "Statement of Questions Presented" at the very outset of the brief for the Commissioner of Patents (see first unnumbered page) confirms the statement in our main brief that the Patent Office is still confusing the 1946 Trade Mark Act with the Act of 1905, just as it has done since the 1946 Act first went into effect. Thus, the Commissioner presents as his version of the question presented for decision, "whether the mark 'J C Higgins', not distinctly (*sic*) displayed, is 'primarily merely a surname' within the meaning of Section 2(e) of the Trade Mark Act of 1946."

Nowhere in Section 2(e) of the 1946 Act can be found the expression, "not distinctly displayed", or any wording similar thereto. The law merely prohibits registration of a mark which "is primarily merely a surname" (see "The Questions Presented", first unnumbered page of Appellant's Brief).

Section 5 of the 1905 Act, on the other hand, prohibited registration of a mark "which consists merely in the name of an individual * * * not written, printed, impressed or woven in some particular or *distinctive* manner * * *" (see page 13 of Appellant's Brief; italics ours).

In emphasizing at the outset of his brief the alleged limitation that Appellant's trade-mark J C HIGGINS is "not distinctly displayed", the Commissioner makes it indisputably clear that he is still attempting to apply the 1905 Act. Furthermore, it is clear from the position in which the Commissioner has placed this statement in his brief that this is no mere slip of the tongue. There can be no doubt that the Commissioner gave careful thought to the drafting of his "Statement of Questions Presented". Hence, it is apparent that the Patent Office officials are thoroughly imbued with this fallacious reasoning in their application of Section 2(e)(3) of the new Act to name trademarks, a fallacy which has persisted since the new law went into effect.

This basic error in policy toward name marks was only partially corrected when Commissioner Daniels reversed the Trade-Mark Examiner in *Ex parte Dallioux*, 83 PQ 262, for, as stated in our main brief, the Patent Office, following the Dallioux decision, stubbornly adhered to its apparent reasoning that the new Act was a mere re-write of the old 1905 Act unless the name presented for registration conformed *precisely* to the pattern of *Andre Dallioux*, i.e., consisted of a full given name and a family name.

Commissioner's Argument Not Convincing.

The Commissioner's argument, as summarized on page 2 of his brief, fails to resolve the issues set forth in Appellant's brief and is convincing only to the effect that the Patent Office was in error and should be reversed. Taking up in order the four points presented in the Commissioner's summary:

1. We can agree without reservation with the Commissioner's statement that Higgins is a surname. However, here the Commissioner is attempting to dissect the trade-mark, which he has no right to do. The mark is J C HIGGINS, *not* Higgins.

2. Here, of course, the issue is joined when the Commissioner arbitrarily insists two initials do not prevent "it" (Higgins) from being merely a surname. It would be interesting to ask if addition of two *other* letters would render the mark registrable, let us say AL HIGGINS or ED HIGGINS? Now, that would fit the "ANDRE DAL-
LIOUX" pattern. If it is agreed that such *would* be registrable, we ask—why the stigma about the particular letters J C?

3. In the third point of the Commissioner's summary, he merely supports the Trial Court's refusal to receive any evidence in the so called "trial". We say the trial judge was in error in this regard. Hence there is an issue on this ancillary question.

4. Here the Commissioner presents the totally irrelevant, immaterial question of whether or not Appellant's trade-mark may be registered under Section 2(f) of the 1946 Act. *Appellant is not requesting registration under Section 2(f)*; hence, there is no need for the Court to waste its time in consideration of this point.

We agree with the Commissioner's statement, page 3, that *Kimberly-Clark Corp. v. Marzall*, 93 PQ 191 is *not a precedent* for the instant case. In that case this Honorable Court had for consideration the trade-mark "Kimberly-Clark", which was found to be merely two surnames. In the case here at bar, on the other hand, we have quite a different issue, *i.e.*, the name of a living individual, J C HIGGINS, who on the record recognized the trade-mark as *his name*, giving Appellant the right to use and register the same.

Decisions under 1905 Act Not in Point.

In devoting considerable space (pp. 4-6) to a discussion of cases decided under the 1905 Act, the Commissioner further confirms our statement that the Patent Office officials are still fallaciously thinking in terms of the old statute. As stated by Commissioner Daniels in the *Dallioux* case, the effect of the Patent Office practice in name cases under the 1946 Act has been

"to continue the rule of the Act of 1905, even though the prohibition against registration of a mark consisting of the name of an individual (which included surnames but was not restricted thereto), no longer remains the law."

Since the 1905 Act prohibited registration of "the name of an individual", *not* a "surname" as in the 1946 Act, it goes without saying that the Patent Office under the 1905 Act would refuse not only a surname, but even a full name such as Bob Burnham (*In re Sears, Roebuck & Co.*, 132 F. 2d 341).

It is not necessary to *speculate* as to the meaning of the word "merely", as employed in Section 2(e) of the Statute. Commissioner Daniels clearly perceived the sig-

nificance of this language when, in the *Dallieux* decision, after emphasizing that the new law could not have been intended to re-enact the same provisions as the 1905 Act, he pointed out (page 263) that, of course, his reasoning would not apply “in the event the surname was unduly emphasized or otherwise constituted the only significant part of the mark, thereby amounting to ‘*a mere device or contrivance to evade the law*’ * * *” (*Italics ours.*)

This is the *only* conclusion which can logically be drawn from the discussions of the legislative hearings in connection with the 1946 Act (see Appendix to our main brief, pp. 3a-8a, inclusive).

Applying Mr. Daniels’ reasoning to the mark J C HIGGINS, there is no basis whatsoever for assuming that this mark is a “mere device or contrivance to evade the law”, for in our case the surname is *in no sense* “unduly emphasized”.

Full Name Not Required.

The only conclusion to be drawn from the Patent Office practice in requiring that a personal name, to be registrable, must conform to the *Andre Dallieux pattern*, is that the Office is attempting to *legislate administratively* that a trade-mark will be registered only if the mark is a *full name*. However, it is again pointed out that while in the legislative hearings (see our main brief, Appendix, p. 4a) it was suggested at one stage that the section read “full name”, the word “full” *does not appear* in the section as enacted and for this reason it is clear that the Patent Office policy in this regard is *contrary to the clear intent of the Congress*.

Infringement Cases Not in Point.

The Commissioner again slips into error when on pages 6-7 of his brief, he refers to the *Thaddeus Davids* case, 233 U.S. 461, a trade-mark infringement suit, and then raises the dire spectre of what *might* happen if Appellant should endeavor to assert its trade mark against use of the name Higgins alone. This latter conjecture is as much of a straw man as reference to the cited trade-mark infringement case and has no more claim to consideration by this Court. We are dealing here with the simple question of *registrability of a specific name under a specific statute* and there is no need to becloud this simple issue with such extraneous considerations. Besides, the Commissioner forgets that Higgins Industries, Inc., sees "no conflict" between J C HIGGINS and their "HIGGINS" (see our main brief, p. 27).

In the *Thaddeus Davids* case, plaintiff had a registration of the name "DAVIDS" under the 10-year proviso of the 1905 Act, although the Court reaffirms the common law rule that no one is entitled to exclusive rights in a surname as a trade-mark.

By means of emphasis to suit his desired conclusion, the Commissioner's quotation (p. 7) fails to convey the actual holding of the Supreme Court in the *Thaddeus Davids* case, which was that the defendant had made a "*colorable imitation*" of the plaintiff's label by putting "C. I. DAVIDS" where plaintiff had "DAVIDS" and placed "DAVIDS MFG. CO." where plaintiff had "THADDEUS DAVIDS CO." Thus, the emphasis should be placed on the Court's language as follows:

"The use of the name *in this manner* * * * constituted a colorable imitation within the meaning of the Act."

In this connection, it is interesting to consider *R. B. Davis Co. v. Julius J. Davis*, 8 F. Sup. 905, 25 T.M. Rep. 61; reheard, 25 T.M. Rep. 283 (ED NY, 1935), where the court held that the defendant's operation under the name Julius J. Davis was "a business fraud", even though the defendant's *full* name was used. This points up the error of citing equity decisions in an *ex parte* registration case.

Again, in *Tanqueray, Gordon & Co. v. Gordon*, 10 F. Sup. 852; affirmed 77 F. 2d 998 (CCA 3, 1935) defendant was enjoined against use of the name "Gordon" on gin because plaintiff had popularized the same name on the same product. This result was reached because of the unfair competition factors involved in the case, despite the basic principle that an ordinary surname cannot usually be the subject of exclusive appropriation as a trade-mark. (*Dauids v. Dauids*, 233 U.S. 461, 34 S. Ct. 648, 58 L. Ed. 1046.)

The point to be considered in the above discussion is that, when the Commissioner puts his faith in equity cases, which invariably include questions of *unfair competition* as well as trade-mark infringement, he is building his house on quicksand. If, as he and the Trial Court maintain, we are dealing here with a pure "question of law", then those cases are completely irrelevant.

The *Williams* opposition cited by the Commissioner (p. 8) is likewise not in point, once we know *all the facts* of the case. The applicant sought to register "E. W. WILLIAMS" and opposer showed ownership of 21 registrations, including some for the notation, "THE J. B. WILLIAMS CO.," for similar goods. This fact seems to have escaped the Solicitor for the Commissioner in his review of the case.

The Commissioner held for the applicant, but was reversed by the Court on the ground of likelihood of confusion. The Court may have been impressed by the difficulty of distinguishing "E. W. WILLIAMS" from "J. B. WILLIAMS." At any rate, it was an opposition proceeding, and the question of confusing similarity with any *specific mark* has *not yet arisen* in the instant case.

**Sawyer Case in Point — But Not for the Reasons
Given by the Commissioner.**

From the Commissioner's discussion (brief, p. 6) of *In re Sawyer*, 144 F. 2d 893, 32 CCPA 740, one receives quite an erroneous impression of what this case actually holds. The Commissioner refers to "the addition of initials" in the same sentence in which he cites this case, but the mark involved was "SAWYER" in block letters and the decision makes *no reference whatever to initials*, even by way of *dictum*. In considering registrability of the name "SAWYER" under the 1905 Act, the Court properly held that since the Act prohibited registration of "the name of an individual", SAWYER was not properly registrable.

In reaching this conclusion, the Court referred (p. 895) to the dictionary definition of the word "merely" as, "without including anything else; purely; only; solely." By this definition, "SAWYER" was unquestionably *merely* a "name of an individual".

It is a rather severe strain on the *Sawyer* case, in view of the above, for the Commissioner to hold it up as authority for the case at bar. Can it be said that J C HIGGINS is *purely* a surname, *only* a surname, *solely* a surname. *without including anything else*? The question answers itself. If this case is authority for the case at bar, *it is determinative in Appellant's favor*.

Registration Statute Codifies the Common Law.

As pointed out in the Committee Reports (see our main brief, pp. 11-12), the purposes of the 1946 Trade Mark Act were *inter alia* to codify the common law and give maximum protection to business. "This bill effects maximum codification and coordination."

This is in line with the remarks of his Honor, Judge Jackson, when he stated in *In re Sawyer*, 144 F. 2d 893, 895:

"The Trade-Mark Registration Act adds nothing to or takes nothing from the common law rights relating to trade-mark ownership and use. It merely provides that owners of such marks may have them registered and made public, and for remedies in the enforcement of such rights. This doctrine is so elementary that no citation of authorities is deemed necessary.

"It is further well-established that a mark consisting of an *ordinary surname* is not the subject of exclusive appropriation as a common law trade-mark. *American Tobacco Co. v. Wix*, *supra*; *Thaddeus Davids Mfg. Co.*, 233 U.S. 461, 34 S. Ct. 648, 58 L. Ed. 1046; *Brown Chemical Co. v. Meyer*, 139 U.S. 540, 11 S. Ct. 625, 35 L. Ed. 247; *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U.S. 118, 25 S. Ct. 609, 49 L. Ed. 972." (Italics ours.)

Undoubtedly, Sec. 2(e) was incorporated in the 1946 Act in codification of this "well established" common law principle against exclusive appropriation of "an ordinary surname."

It has been recognized, in the absence of fraud, that a person's initials are sufficient to distinguish him from a competitor having the same family name. See *Henry Perkins v. Perkins*, 246 Mass. 96, 140 N.E. 461, 13 T.M. Rep. 370, where defendant was allowed to continue doing business under the firm name, H. K. Perkins & Co., al-

though plaintiff had prior rights in "Perkins" as a trademark. This is in line with the basic doctrine laid down by the Supreme Court in *Howe Scale Co. v. Wykoff*, 198 U.S. 118, 140, 25 S. Ct. 609, 49 L. ed. 972, that

"in the absence of contract, fraud or estoppel, any one may use his own name in all legitimate ways * * *"

This is still the law.

Summarizing as to the common law: The decided cases are a generally *unsafe* guide for our problem because of the unfair competition aspects invariably present in those cases, and because the cases are seemingly conflicting—thus, exclusive rights were recognized in a surname alone not only in the *Davids* case but in a number of others. (See Pike, "Personal Names as Trade Symbols," 32 Bull. T.M. Assn. 121,130.)

However, it can be said that *nowhere* have we found, either in the cases or texts, a categorical statement against exclusive appropriation of a mark of the J C HIGGINS type, such as Judge Jackson expressed against a surname in the *Sawyer* case (*supra*).

CONCLUSION.

(1) The Commissioner's brief fails to meet in an iota the cogent reasons advanced in our main brief for reversing the lower tribunals. His "authorities" are either decisions under the superseded 1905 Act, or are *inter partes* cases where totally different issues were involved, and both categories of cases have no persuasive bearing on the issue here involved. In this connection it should be borne in mind that J C HIGGINS is *not* being refused because of confusing similarity with another mark.

(2) There is no justification for the Solicitor's insinuation (p. 10) that Appellant "seems unwilling to risk" an attempt to register under Sec. 2(f), any more than a drug clerk would be warranted in casting aspersions on a customer who insists on Bayer's Aspirin instead of "Dr. Quack's Just-as-Good" aspirin. Appellant is paying the fee and is believed entitled to specify the protection to which it believes it has a right under the law.

(3) Commissioner Marzall, in a recently presented paper on "Trade-Marks", 42 T.M. Rep. 805 (Nov. 1952), pointedly refers to Sec. 2(e)(3), saying (p. 806) that while under the prior law "surnames were not registrable", the 1946 Act changed the prohibition to the words, "primarily merely a surname". After referring to the *Kimberly-Clark decision*, 93 PQ 191, and that of *Andre Dallioux*, 83 PQ 262, Mr. Marzall makes the extremely interesting remark (p. 807):

"We now come to the proposition as to whether or not D. B. Smith would be registrable in that the initials D.B. *removes the objection* of that part of the section." (Italics ours.)

The author at this point goes on to discuss something else. But it hardly requires a mind reader to see that, so far as Mr. Marzall's views are concerned, J C HIGGINS should be registered.

(4) The prior tribunals were *clearly in error* in refusing registration. The Commissioner admits (p. 3) that he knows of no case squarely in point, and then proceeds to discuss cases which, as we have pointed out, *are not at all in point*. Since the Patent Office fell into error long ago in construing the new law as a rewrite of the old, the Commission seems to feel that, at the cost of all reason and logic, that error must be justified. Such clear error should

be set aside. *A. & P. v. Supermarket*, 87 PQ 303, 333 U. S. 364.

This case is of the highest public importance. Not only does this Appellant have 16 other copending applications for the same mark; many other cases for other applicants are doubtless pending involving this identical issue.

It is, therefore, respectfully urged that the Trial Court be reversed.

Respectfully submitted,

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January 27, 1953.

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**United States Court of Appeals
District of Columbia Circuit**

*United States Court of Appeals
For the
District of Columbia Circuit*

APPEAL No. 11454

FILED SEP 24 1932

Joseph W. Stewart

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SEARS, ROEBUCK AND COMPANY, *Appellant*

ROBERT C. WATSON v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,
Appellee

APPEAL FROM THE JUDGMENT OF THE UNITED
STATES DISTRICT COURT FOR THE DISTRICT
OF COLUMBIA

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STATEMENT OF QUESTION PRESENTED

In the opinion of the appellee the only question presented by this case is whether the mark "J C Higgins", not distinctly displayed, is "primarily merely a surname" within the meaning of Section 2 (e) of the Trade-Mark Act of 1946.

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**United States Court of Appeals
District of Columbia Circuit**

APPEAL No. 11454

SEARS, ROEBUCK AND COMPANY, *Appellant*

v.

JOHN A. MARZALL, COMMISSIONER OF PATENTS,
Appellee

APPEAL FROM THE JUDGMENT OF THE UNITED
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BRIEF FOR THE COMMISSIONER OF PATENTS

INTRODUCTION

This is an appeal from a judgment of the United States District Court for the District of Columbia dismissing the complaint in an action under R.S. 4915 (35 U.S.C. 63), in which the appellant sought to register the name "J C Higgins" as a trade-mark for sporting goods. The basis of the refusal was the holding that the mark in question is primarily merely a surname and that its registration is therefore prohibited by

Section 2 (e) of the Trade-Mark Act of 1946, except upon the special showing required by Section 2 (f) of the Act.

SUMMARY OF ARGUMENT

1. The word "Higgins" is primarily, if not solely, a surname.

2. The addition of two initials to the name "Higgins" does not prevent it from being "merely" a surname, within the meaning of Section 2 (e) of the 1946 Trade-Mark Act.

3. The sole issue involved in this case is one of law and appellant's proposed testimony was, therefore, properly excluded by the lower Court.

4. If the mark here involved has become distinctive of appellant's goods, it may be registered under Section 2 (f) of the Act. If it has not become distinctive, it clearly should not be registered.

ARGUMENT

This case presents the issue whether the mark "J C Higgins" is primarily merely a surname within the meaning of Section 2 (e) of the Trade-Mark Act of 1946.

The word "primarily" was inserted into that section in order to prevent the arbitrary refusal to register a word merely because it could be found as a surname in some city directory. The intention was evidently to permit registration of words such as king, cotton, stone and fox which were primarily not names. This distinction is clear from the colloquy between Messrs.

Rogers and Frazer, which appears on page 8a of the appendix to the appellant's brief. It is there indicated that "Johnson is primarily a surname and Cotton is not."

The word "Higgins" cannot be found in the dictionaries except as a surname, and it is evident that this is its primary meaning, although, like any other surname, it may conceivably have been used as a first name. Clearly, however, "Higgins" is similar to "Johnson" rather than to "Cotton", so far as the present issue is concerned, and must be considered to be primarily a surname. In fact, it is not contended by the appellant that "Higgins" alone could be registered.

Since "Higgins" is primarily a surname, it remains only to determine whether the addition of the initials "J C" prevent it from being "merely" a surname. There appears to be no court decision directly in point on that matter so far as the 1946 Trade-Mark Act is concerned. The closest approach is *Kimberly-Clark Corp. v. Marzall*, Appeals Nos. 10932-3, Decided May 1, 1952, 93 USPQ 191, in which it was held that registration of the mark Kimberly-Clark under the 1946 Act was precluded by the language of Section 2 (e). That decision, however, was predicated on the fact that each part of the mark was a surname, and accordingly the case is not squarely in point here. It is significant, however, that this Court based its decision in the 1946 Act case largely on precedents under the 1905 Act.

Section 5 of the 1905 Act does not contain the exact language here under consideration, but it does prohibit registration of a mark which "consists merely in

the name of an individual not written, printed, impressed or woven in some particular or distinctive manner." The Acts of 1905 and 1946 thus contain the word "merely" in substantially the same position, and there is nothing to indicate any intention of changing the meaning of that word. It is therefore important to consider what the word "merely" was held to mean in the 1905 Act.

A consideration of the decisions makes it clear that the word in question was broadly construed, and that the addition of very considerable appendages to a name was held not to avoid the charge that the mark was still merely the name of an individual.

A case quite similar to the present one is *Howard Co. v. Baldwin Co.*, 48 App. D. C. 437. It was there held that a mark consisting of the name Howard with initials V G P Co. arranged in a monogram was not registrable. While the initials were not specifically discussed, it is evident that they were not found to keep the mark from being merely a name. That holding would seem to apply here.

Another case closely in point is *In re Artesian Manufacturing Co.*, 37 App. D. C. 113, in which this Court held "Deacon Brown" to be unregistrable as being merely the name of an individual. The Court stated that the refusal to register "follows former decisions of the Commissioner refusing registration of surnames" and quoted with approval the holding of the Commissioner that:

"The name 'Brown' is a common surname, and the prefixing of the word 'Deacon' thereto no more

renders it registrable than would the prefixing of the word 'Mr.', 'Dr.', 'General', or the like."

The decision just cited was followed by the Court of Customs and Patent Appeals in *In re Marks Shoe Co.*, 131 F. 2d 437, 30 CCPA 704, wherein "Lady Chesterfield" was held unregistrable. In so holding the Court said:

"As the term 'Chesterfield' is in use as a surname, it is the distinguishing feature of appellant's mark. See the *American Tobacco Co. v. Wix*, 20 CCPA 835, 62 F. 2d 835. Accordingly, the addition of the descriptive title 'Lady' to the surname 'Chesterfield' does not render appellant's mark registrable under the Trade-Mark Act of February 20, 1905."

The same Court in *In re Sears, Roebuck & Co.*, 132 F. 2d 341, 30 CCPA 710, refused registration to a mark consisting of a representation of a man's bust and the words "Thriftily yours Bob Burnham" on the ground that the name was the dominant part of it.

Attention is also directed to the decision of this Court in *Tinker v. Paterson*, 53 App. D. C. 37, 287 Fed. 1014, in which it was held that the mark "inTker" was not registrable because it was not sufficiently distinguished from the name "Tinker".

It was the consistent policy of the Patent Office to refuse to register, under the 1905 Act, marks which were dominated by a surname, even though they contained additional features. The following are cited as examples, the mark having been refused registration in each case:

"Roosevelt Rose", the word "Rose" alone having been registered (R. I. Sherman Mfg. Co., 1902 C. D. 475).

"Van Horn" associated with a ram's forehead and horns (Van Horn and Sawtell, 1904 C. D. 87).

"Dr. Pepper" (The Dr. Pepper Co., 1905 C. D. 158).

"Cobb's" extending across a pair of crossed corn-cobs (Cobb, 1903 C. D. 136).

"Atwood", associated with an arrow head and the letter "A" (Pittsburg Valve Foundry and Construction Co., 1907 C. D. 137).

"DuPont", with a coat of arms on which are the letters D P (DuPont v. Ginter, 1921 C. D. 79).

"Tom Walker" beneath two circles enclosing representations of a horse and a tree (John Walker v. W & H Walker Inc., 30 USPQ 375).

In view of the decisions cited, it is submitted to be clear that the word "merely" as used in the expression here under consideration is not limited to the meaning that the mark must include, literally, nothing more than a surname. The addition of initials, designs, pictures or other words will not make the mark registrable if it is dominated by a surname or if, as was said in *In re Sawyer Electrical Manufacturing Co.*, 144 F. 2d 893, 32 CCPA 740, it has a name as its "foundation."

Since the addition of immaterial elements which do not alter the essential or dominant character of a

surname does not make it registrable, the question here presented is reduced to whether or not "J C Higgins" is an essentially different mark from "Higgins", or, in other words, whether a surname with initials is to be regarded as a materially different mark from the surname alone. That exact question was considered by the Supreme Court of the United States in *Thaddeus Davids Co. v. Davids and Davids*, 233 U. S. 461, in which the Court said:

"The complainant put its mark 'Davids' prominently at the top of its labels. The defendants, in the same position on its labels put 'C. I. Davids.' At the bottom of their labels the defendants placed 'Davids Mfg. Co.' The use of the name in this manner was *a mere simulation of the complainant's mark* which it had duly registered; it constituted a '*colorable imitation* within the meaning of the Act.'" (Emphasis added).

It necessarily follows from the quoted language that if the present appellant were successful in registering "J C Higgins" it would be able to enjoin the use of "Higgins" alone as a "colorable imitation" of its registered mark. The effect, therefore, would be exactly the same as if "Higgins" alone had been registered. The appellant, therefore, would be doing indirectly what the statute expressly precludes him from doing directly.

What the appellant's position amounts to is that, although registration of the word "Higgins" is precluded by statute, registration of a mark which, in the

language of the Supreme Court, is a "colorable imitation" of that word is permissible. Such a position is clearly unsound.

The question as to the effect of initials in changing the character of a name trade-mark was also considered by the Court of Customs and Patent Appeals in *J. B. Williams Co. v. Ernest W. Williams*, 48 F. 2d 398, 18 CCPA 1133. That case involved the marks "Williams" and "E. W. Williams." It was held that the name "Williams" was "the clearly dominant and peculiarly noticeable part of each mark" and that the marks were too similar to permit their simultaneous use.

The appellant seems to place great emphasis on the decision of the Assistant Commissioner in *Ex parte Dallieux*, 83 USPQ 262, in which the mark "Andre Dallieux" was held registrable. That decision is specifically distinguished from the present case in the decision of the Examiner-in-Chief (Appendix 56). The holding that the addition of entire first name to a surname makes it registrable is not inconsistent with the holding that the addition of two initials do not make it so. Moreover, even if that decision were inconsistent with the present one, it does not follow that it is the present one which is wrong. It may be noted that the *Dallieux* decision was strongly relied on by the appellant in the *Kimberly-Clark* case, *supra*, but was not considered by the Court to have any material weight. The issue here is simply whether the decision appealed from is correct, not whether it is consistent with any and all prior Patent Office decisions.

The appellant also suggests that the letters "J C", if used by themselves as a trade-mark, would be registrable. Assuming that to be true, it is not material here. In the Sherman case cited above, it was held that "Roosevelt Rose" was not registrable, although "Rose" alone was; and no doubt the pictures of the tree and horse in the Walker case, or the bust and inscription "Thriftily yours" in the Sears, Roebuck case would have been registrable alone. Similarly, "General" and "Admiral" alone are registrable, but "General Brown" or "Admiral Brown" would be no more registrable than "Deacon Brown". The issue presented is simply whether the part which dominates the mark is registrable. If it is not, it is of no consequence that some subsidiary part might be registered if it had been used alone.

Since the issue here presented is purely one of law, the Court below properly excluded the appellant's proposed evidence. If the mark here involved is not primarily merely a surname, it can be registered and no evidence is necessary. If it is primarily merely a surname, it is not registrable on the application here involved. No amount or duration of use, and no evidence as to how the mark is used, can alter its character in that respect.

Some of the proposed evidence, and some of the appellant's arguments, appear to be aimed at the idea that appellant has acquired a right to register the mark through long and exclusive use. Such a right may be acquired under Section 2 (f) of the 1946 Trade-Mark Act, which is as follows:

“(f) Except as expressly excluded in paragraphs (a), (b), (c), and (d) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration. (15 U.S.C. 1052)”

The appellant, however, has declined to seek registration under that section and, although suggesting that it has had exclusive use of the mark for a long period, seems unwilling to risk its right to register on that issue. Under these circumstances, there can be little equity in appellant's favor. Obviously, if others have used the mark recently, the registration should not be granted and, if they have not, the appellant has only to establish that fact to obtain a registration under Section 2 (f).

Appellant urges that doubts should be resolved in favor of registration. That may be true in the initial consideration of the case, but where, as here, there are concurring decisions by the Patent Office and the lower Court that a mark is not registrable, something more than a doubt is required to upset them. As was said by this Court in *Minnesota Mining and Mfg. Co. v. Coe*, 73 App. D. C. 146, 118 F. 2d 593:

“Whatever else may be said of older decisions that, in appeals from the Patent Office, doubt was to be resolved in favor of the applicant, they are obviously not law in relation to appeals from the district court.”

The same principle would, of course, apply in trademark registration cases.

The present case is one in which the performance of the official duties of the Patent Office required it to make an interpretation of the law. It is well settled that, in such a case, the interpretation made will not be disturbed by the courts unless it is clearly wrong. (Hammond v. Hull, 76 U. S. App. D. C. 301, 131 F. 2d 23. Abbott v. Coe, 71 App. D. C. 195, 109 F. 2d 449. Daniels v. Coe, 73 App. D. C. 54, 116 F. 2d 941).

CONCLUSION

The question here involved is a simple one and has been fully and carefully considered by two Patent Office tribunals and by the District Court. It is submitted that their conclusion is sound in principle and is supported by adequate authority, and that the decision appealed from should, therefore, be affirmed.

Respectfully submitted,

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September 1952